IN THE

Supreme Court of the United States

OCTOBER TERM, 1941

No. 680

U. S. INDUSTRIAL CHEMICALS, INC.,
Petitioner,

vs.

CARBIDE AND CARBON CHEMICALS CORPORATION,
Respondent.

APPENDIX I TO BRIEF FOR RESPONDENT

Fox Printing Company, Inc., 80 Lafayette Street, New York, N. Y.

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APPENDIX I.

DIGEST OF DECISIONS OF THIS COURT IN REISSUE PATENT CASES 1832 TO 1940

THE STATUTE.

Authority for surrender of a defective original patent and for the grant of a corrected reissue patent is provided by Revised Statute §4916 (U. S. C., title 35, sec. 64):

"Whenever any patent is wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a patent for the same invention, and in accordance with the corrected specification, to be reissued to the patentee or to his assigns or legal representatives, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the reissued patent, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent to the extent that its claims are identical with the original patent shall constitute a continuation thereof and have effect continuously from the date of the original patent. The commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand

of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. The specifications and claims in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specifications, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in the case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid."

The statutory prerequisites are thus:

1. The original shall be at least partially inoperative or invalid by reason of a defective or insufficient specification or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new.

2. The error of the original shall have arisen

(a) by inadvertence, accident or mistake,

(b) and without any fraudulent or deceptive intention,

3. The reissued patent shall be for the same invention and in accordance with the corrected specification.

ADDITIONAL PREREQUISITES

This Court, in the course of deciding many cases under the statute, has announced as further implicit prerequisites of a valid reissue:

1. There shall be no unreasonable delay in applying for reissue.

2. Application for the reissue, if to broaden the patent claim, shall be made within two years* of the grant of the original patent.

3. The "same invention" patented by the reissue shall be subject matter substantially indicated in the original patent and therein indicated as intended to be subject matter invented and claimed by the patentee.

RESUME OF DECISIONS OF THIS COURT

It is believed that several broad principles run harmoniously through all the reported Reissue cases from 1832 to date. These are briefly stated as follows:

Settled Principles Regarding Inoperativeness or Invalidity of Original Patent by Reason of Defective or Insufficient Specification

It is established that this prerequisite embraces a failure of the original patent fully to *protect* the true invention as well as a failure correctly to *describe* it.

The failure of *protection* may arise from the original claims being too *narrow* or from the original claims being too *broad*. The failure of *description* may be one of deficiency or excess.

* Perhaps now, by analogy, one year (Act of August 5, 1939; 53 Stat. 1212) as to reissue of patents applied for since *August 5, 1940*.

Settled Principles Regarding Inadvertence, Accident or Mistake and Without Fraudulent or Deceptive Intention

The defect of the original patent must have occurred innocently by circumstances of inadvertence, accident or mistake justifying relief by a court of equity.

The file-wrapper of the original patent, showing its course through the Patent Office, may be examined, particularly where the defect concerns the factor of scope of protection. For example, where the reissue claims broaden the protection, it must appear that the undue narrowness of the original claims was not made with forethought necessarily to distinguish from the prior art.

On the other hand, where the defective narrowness of the claims of the original patent has arisen from an error partly or wholly chargeable to the Patent Office or from an explainable and not unreal error chargeable to the patentee, the situation is proper for correction by reissue.

The file wrapper of the reissue application together with other evidence may be considered in explanation of the occurrence of the defect of the original.

The Commissioner of Patents has the responsibility of passing on the fact question of whether the defect of the original arose from inadvertence, accident or mistake, and the Commissioner's action in granting the reissue is conclusive on that question in the absence of fraud.

Settled Principles Regarding "Same Invention"

I.

The reissue statute is remedial, and it essentially requires good faith compliance with all the prerequisites. Accordingly, the motive for the reissuance is an important preliminary inquiry in reaching judgment.

Reissue for the purpose of effectuating *protection* of the patentable subject matter disclosed, and indicated as intended to be asserted as the patentee's invention, by the original patent is consistent with the reissue patent being for the same invention and is indicated by the fact that discovery of the defect does not arise after, and from knowledge of, another's independent and different operations, and by the fact that the remedy sought is not motivated to entrap such interim operations.

On the contrary, reissue for the purpose of describing a material difference in subject matter, or of embracing within the claims a materially different and particularly an originally unknown thing, is inconsistent with the reissue patent being for the same invention.

II.

In judging whether the original and reissue patents are for the same invention, it is necessary to determine what the true inventive subject matter in the original patent was, and this inquiry involves an appraisal of the novelty and utility of the invention against the background of the prior art and against the foreground of its effect on its art, whereby the invention may be properly ranked as a narrow improvement or as radically new, and as contributing to the progress of the art or as without commercial affect.

III.

The factors of identity and difference between the original and reissue patents, by which the question of whether or not the patents are for the "same invention" is to be resolved, can sometimes be identified and evaluated in the case of simple and easily understandable inventions from a comparison of the original and reissue patents themselves.

These factors and their evaluation in the case of abstruse inventions are to be determined in the light of testimony of workers skilled in the particular art involved regarding what the patents disclose to them, as well as in the light of direct comparison of the original and reissue patents themselves.

In judging the legal effect of differences between an original patent and its reissue patent, it must preliminarily be determined what their functional significance is. In other words, the preliminary inquiry must be as to whether or not, *to the skilled worker in the art,* these differences are essential or necessary or vital or substantial or material with respect to the integrity of the thing under inquiry.

The question of whether the differences are matters of essence (and thus fall in the category which makes the reissue not for the same invention), or immaterialities (and thus fall in the category which makes the reissue still for the same invention) is determined in the light of

(a) definitions and statements made by the original patent and the reissue patent themselves

(b) evidence of the understanding of the subject matter imparted by the patents to workers skilled in the special art, *i. e.*, by expert testimony

(c) a comparison between the subject matter described by the original patent and the subject matter constituting the defendant's alleged infringement of the reissue patent

(d) whether the claims of the reissue could have been made on the description contained in the original patent, or on the contrary rested only on the altered description of the reissue patent

(e) an evaluation of the subject matter–including the differences, and determination whether such subject matter was patentable independently over the subject matter excluding such differences.

Whether the differences are of the character (as to subject matter) which makes the reissue for the same invention as the original, or in the category (as to subject matter) which makes the reissue not for the same invention, is a question of fact.

The legal effect of the differences between the original patent and the reissue patent is a question of law. If the differences are essential, or necessary, or vital, or substantial, or material, the reissue is not for the same invention and hence is invalid. If the differences are non-essential, or unnecessary, or immaterial, or insubstantial, then the reissue is, in law, for the same invention and hence valid.

THE DECISIONS ON REISSUE PATENTS

GRANT v. RAYMOND, 31 U. S. 217 [1832]

Interval—4 years

Motive of Reissue—This was a case antedating any statutory provision for patent reissue. Nevertheless, since the original was discovered to be defective, it had been surrendered and a new patent issued.

Subject Matter—Manufacture of Hat Bodies

HELD

"The laws which are passed to give effect to this purpose ought, we think, to be construed in the spirit in which they have been made; and to execute the contract fairly on the part of the United States, where the full benefit has been actually received; if this can be done, without transcending the intention of the statute, or countenancing acts which are fraudulent, or may prove mischievous. The public yields nothing which it has not agreed to yield; it receives all which it has contracted to receive. The full benefit of the discovery, after its enjoyment by the discoverer for fourteen years, is preserved; and for his exclusive enjoyment of it, during that time, the public faith is pledged. That sense of justice and of right which all feel, pleads strongly against depriving the inventor of the compensation thus solemnly promised, because he has committed an inadvertent or innocent mistake.

If the mistake should be committed in the department of state, no one would say, that it ought not to be corrected. All would admit, that a new patent, correcting the error, and which would secure to the patentee the benefits which the law intended to secure, ought to be issued. And yet

the act does not, in terms, authorize a new patent, even in this case. Its emanation is not founded on the words of the law, but is indispensably necessary to the faithful execution of the solemn promise made by the United States. Why should not the same step be taken, for the same purpose, if the mistake has been innocently committed by the inventor himself?" (240-242)

"If, by an innocent mistake, the instrument introduced to secure this privilege fails in its object, the public ought not to avail itself of this mistake, and to appropriate the discovery, without paying the stipulated consideration. The attempt would be disreputable in an individual, and a court of equity might interpose to restrain him." (243)

STIMPSON v. WESTCHESTER RAILROAD CO., 45 U. S. 379 [1846]

Interval—4 years

Motive of Reissue—Modification of claim to dominate interim construction.

Subject Matter—The original was for an arrangement of wheel flanges on one side of railroad cars and of the wheel treads on the other side to allow short radius turns.

HELD

"Whether the new patent was substantially for a different invention from the first one, was a question for the jury on the evidence." (403)

O'REILLY, *et al.* v. MORSE, 56 U. S. 61 [1853]

Interval—8 years

Motive of Reissue—Modifying claims to effectuate protection.

Subject Matter—This was the basic Morse telegraph invention.

HELD

"Regarding Professor Morse as the first and original inventor of the Telegraph, we come to the objections which have been made to the validity of his patent.

We do not think it necessary to dwell upon the objections taken to the proceedings upon which the first patent was issued, or to the additional specifications of the reissued patent of 1848. In relation to the first, if there was any alteration at the suggestion of the commissioner, it appears to have been a matter of form, rather than of substance; and, as regards the second, there is nothing in the proof or on the face of the reissued patent to show that the invention therein described is not the same with the one intended to be secured by the original patent. It was reissued by the proper lawful authority; and it was the duty of the commissioner of patents to see that it did not cover more than the original invention. It must be presumed, therefore, that it does not, until the contrary appears. Variations from the description given in the former specification do not necessarily imply that it is for a different discovery. The right to surrender the old patent, and receive another in its place, was given for the purpose of enabling the patentee to give a more perfect description of his invention, when any mistake or oversight was committed in his first. It necessarily, therefore, varies from it. And we see nothing in the reissued patent

that may not, without proof to the contrary, be regarded as a more careful description than the former one, explaining more fully the nice and delicate manner in which the different elements of power are arranged and combined together and act upon one another, in order to produce the effect described in the specification." (111-112)

BATTIN v. TAGGERT, 58 U. S. 74 [1854]

Interval—6 years

Motive of Reissue—To alter subject matter of claim

Subject Matter—The original claimed a combination of breaking rollers and screen for coal. The reissue claimed the breaking rollers only and of a particular construction.

HELD

"Whether the defect be in the specifications or in the claim, under the 13th section above cited, the patentee may surrender his patent, and, by an amended specification or claim, cure the defect. The reissued patent must be for the same invention, substantially, though it be described in terms more precise and accurate than in the first patent. Under such circumstances, a new and different invention cannot be claimed. But where the specification or claim is made so vaguely as to be inoperative and invalid, yet an amendment may give to it validity, and protect the rights of the patentee against all subsequent infringements." (82)

"The plaintiff, by a surrender of that patent, and the procurement of the patent of 1849 with amended specifications, abandoned his first patent, and relied wholly on the

one reissued. The claim and specifications in this patent, as amendatory of the first, were within the 13th section of the act of 1836. It is said; with entire accuracy, in the charge, in regard to the amended specification of the patent of 1849, that it 'described essentially the same machine as the former one did, but claimed, as the thing invented, the breaking apparatus only.' And this the patentee had a right to do. He had a right to restrict or enlarge his claim, so as to give it validity, and to effectuate his invention." (83-84)

"The jury are also to judge * * * whether the renewed patent is for the same invention as the original patent; * * *." (84)

BURR v. DURYEE, 68 U. S. 531 [1863]

Interval—14 years

Motive of Reissue—To enlarge both disclosure and claim to dominate interim device

Subject Matter—The original narrowly claimed particular elements and arrangements of a fiber hat body machine. The reissue broadly claimed a combination of three elements.

HELD

1.

"Let us consider what was the original invention of Wells, as described and claimed by himself, without regard to this ingenious attempt by the assignee to expand it into an abstraction.

It is not within the category of those inventions which consist in a new application of certain natural forces to

produce a certain result to which they had never before been applied, and which, when once pointed out, required no invention to construct devices for its application. Such inventions partake of the nature of discoveries, either found out by experiment or the result of a happy thought, which, when once expressed, is plain to all intelligent persons, who could point out at once many devices for making it effectual. Any one can perceive the difference of such a case from the invention of a labor-saving machine, which is a mere combination of certain mechanical devices to produce a desired manufacture in a cheaper or better manner." (568)

"It is plain that the invention of Wells had nothing of the nature of a discovery, or the new application of some power of nature to the perfection of an art or the operation of a machine, such as the application of the electro-galvanic fluid to the art of telegraphic writing. It was simply a concrete machine, an improvement on other known machines, and nothing more." (569)

2.

"The original patent of Wells has been more than once decided by the courts to be a valid patent. The specification states clearly and correctly what the invention is; what the patentee claims as his peculiar improvement on former machines; what are the devices, or peculiar combination of them, which make it to differ, and the mode in which they operate to produce the required result. He claims all he had a right to claim as new, and no more. There is no error from 'inadvertence, accident, or mistake.'" (571)

3.

"Now, the machine of Boyden has not one of the peculiar devices, or combination of devices, of the Wells machine, nor any substantial identity with it, unless by substantial identity is meant every machine which produces the same effect. These abstract phrases, '*substantial* identity,' 'equivalent,' 'mode of operation,' &c., are often used in such a vague and equivocal manner, that they mystify and lead many to absurd conclusions, who will not distinguish between things that differ. That two machines produce the same effect, will not justify the assertion that they are substantially the same, or that the devices used by one are, therefore, mere equivalents for those of the other. There is nothing in the Wells machine or its devices which suggests the peculiar device employed by Boyden. His machine has no tunnel, no cap, no flap, nor any equivalent therefor, nor does it incorporate in its structure the substance of the first invention. There is nothing to be found in the specification of Wells which would ever suggest the peculiar device of the Boyden machine. As an improvement, it has more claim to originality than that of Wells." (572)

"The patent to Boyden was issued on the 10th of January, 1860. The complainants were invited to examine it. They did so, accompanied by their counsel and other experts. After this, the complainants surrendered their valid patent, or rather its reissue of 1856, and have another reissue, which is now contended to have been made so elastic or expanded that it may be used to suppress all other inventions which have been made or may be made to effect the same purpose." (573-574)

"We concur, therefore, in the decision of the Circuit Court, that the machine of Boyden is not an infringement of the invention of Wells; and if it be an infringement of the reissued patent, that patent is void." (577)

MOREY v. LOCKWOOD, 75 U. S. 230 [1868]

Interval—8 years

Motive of Reissue—Enlargement of claim to effectuate protection erroneously denied by Patent Office in granting original.

Subject Matter—The original claim was limited to a syringe in which the sac tubes and valve boxes were disposed in the same axial line. This original limitation was caused by an error of the Patent Office with respect to a prior art disclosure and a failure of the patentee originally to perceive the error. The reissue enlarged the claim to cover any arrangement of these elements.

HELD

"We do not doubt that the commissioner had full authority to grant the amendment; and, under the special circumstances of the case, it would seem to have been a duty, as the inventors were led into the error by himself, as may be seen from his letter when the patent was originally granted. The amendment was very material, as the language of the original claim tied the patentees down to a syringe, consisting of the parts mentioned, to an instrument in which they were arranged in an axial, or straight line; tying them down to the mere form of the construction, regardless of the substance and legal import of the invention. While the original specification and claim remained, it was competent

for any one to evade the patent, and enjoy the substance of the improvement by a change in the mere form of the construction; that is, by an arrangement of the several parts in any form, if not in an axial or straight line. And this is what the defendants are endeavoring to accomplish, and would have accomplished, if the amendment of the claim had not been allowed." (240-241)

RUBBER COMPANY v. GOODYEAR, 76 U. S. 788 [1869]

Interval—16 years

Motive of Reissue—To claim product instead of process

Subject Matter—This involved the basic Goodyear vulcanization patent

HELD

"But liberality, rather than strictness, should prevail where the fate of the patent is involved, and the question to be decided is whether the inventor shall hold or lose the fruits of his genius and his labors." (795)

BISCHOFF v. WETHERED, 76 U. S. 812 [1869]

Subject Matter—This was not a reissue patent. However, the Court passed on the issue of same invention and the character of relevant evidence.

HELD

"A case may sometimes be so clear that the court may feel no need of an expert to explain the terms of art or the descriptions contained in the respective patents, and may, therefore, feel authorized to leave the question of identity

to the jury, under such general instructions as the nature of the documents seems to require. And in such plain cases the court would probably feel authorized to set aside a verdict unsatisfactory to itself, as against the weight of evidence. But in all such cases the question would still be treated as a question of fact for the jury, and not as a question of law for the court. And under this rule of practice, counsel would not have the right to require the court, as matter of law, to pronounce upon the identity or diversity of the several inventions described in the patents produced. Such, we think, has been prevailing rule in this country, and we see no sufficient reason for changing it. The control which the courts can always exercise over unsatisfactory verdicts will enable them to prevent any wrong or injustice arising from the action of juries; whereas, if the courts themselves were compellable to decide on these often recondite and difficult questions, without the aid of scientific persons familiar with the subjects of the inventions in question, they might be led into irremediable errors, which would produce great injustice to suitors. We are disposed to think that the practice adopted by our courts is, on the whole, the safest and most conducive to justice.

It may be objected to this view that it is the province of the court, and not the jury, to construe the meaning of documentary evidence. This is true. But the specifications of patents for inventions are documents of a peculiar kind. They profess to describe mechanisms and complicated machinery, chemical compositions and other manufactured products, which have their existence *in pais*, outside of the documents themselves; and which are commonly described by terms of the art or mystery to which they respectively belong; and these descriptions and terms of art often require peculiar knowledge and education to understand

them aright; and slight verbal variations, scarcely noticeable to a common reader, would be detected by an expert in the art, as indicating an important variation in the invention. Indeed, the whole subject-matter of a patent is an embodied conception outside of the patent itself, which, to the mind of those expert in the art, stands out in clear and distinct relief, whilst it is often unperceived, or but dimly perceived, by the uninitiated. This outward embodiment of the terms contained in the patent is the thing invented, and is to be properly sought, like the explanation of all latent ambiguities arising from the description of external things, by evidence *in pais*." (814-815)

"This view of the case is not intended to, and does not, trench upon the doctrine that the *construction* of written instruments is the province of the court alone. It is not the *construction of the instrument*, but the *character of the thing invented*, which is sought in questions of identity and diversity of inventions." (816)

SEYMOUR v. OSBORNE, 78 U. S. 516 [1870]

Interval—10 years

Motive of Reissue—Not stated

Subject Matter—Grain reapers

HELD

"Reissued letters patent must, by the express words of the section authorizing the same, be *for the same invention*, and consequently where it appears on a comparison of the two instruments, as matter of law, that the reissued patent is not for the same invention as that embraced and secured in the original patent, the reissued patent is invalid, as that

state of facts shows that the commissioner, in granting the new patent, exceeded his jurisdiction. Power is unquestionably conferred upon the commissioner to allow the specification to be amended if the patent is inoperative or invalid, and in that event to issue the patent in proper form; and he may, doubtless, under that authority, allow the patentee to redescribe his invention and to include in the description and claims of the patent not only what was well described before but whatever else was suggested or substantially indicated in the specification or drawings which properly belonged to the invention as actually made and perfected." (544)

"Corrections may be made in the description, specification, or claim where the patentee has claimed as new more than he had a right to claim, or where the description, specification, or claim is defective or insufficient, but he cannot under such an application make material additions to the invention which were not described, suggested, nor substantially indicated in the original specifications, drawings, or patent office model." (545)

"Letters patent reissued for an invention substantially different from that embodied in the original patent are void and of no effect, as no jurisdiction to grant such a patent is conferred by any act of Congress upon the commissioner, and he possesses no power in that behalf except what the acts of Congress confer. Whether a reissued patent is for the same invention as that embodied in the original patent or for a different one is a question for the court in an equity suit to be determined as a matter of construction, on a comparison of the two instruments, aided or not by the testimony of expert witnesses, as it may or may not appear that one or both may contain technical

terms or terms of art requiring such assistance in ascertaining the true meaning of the language employed.

Where the specification and claim, both in the original and reissued patents, are expressed in ordinary language, without employing any technical terms or terms of art, the question whether the reissued patent is for the same invention as that described in the original patent or for a different one is purely a question of construction, but where both or either contain technical terms or terms of art the court may hear the testimony of scientific witnesses to aid the court in coming to a correct conclusion. Cases doubtless arise where the language of the specification and claim, both of the surrendered and reissued patents, is so interspersed with technical terms and terms of art that the testimony of scientific witnesses is indispensable to a correct understanding of its meaning." (545-546)

CARLTON v. BOKER, 84 U. S. 463 [1873]

Interval—10 years

Motive of Reissue—Alteration of subject matter claimed, to dominate interim device

Subject Matter—The original narrowly claimed a lamp burner. The reissue changed the claim to cover a lighter of different construction.

HELD

The patent burner was "of little value". (465)

"Therefore, with these burners before us, all the invention we can discover in Reichmann's burner is the peculiar mode of supporting his dome by slender arms attached to a sleeve

fitted on to the wick-tube, and the elevation of the chimney on the outer edge of the dome. The latter peculiarity, as we have seen, is a defect which rendered the burner nearly useless." (468)

"We think it proper to reiterate our disapprobation of these ingenious attempts to expand a simple invention of a distinct device into an all-embracing claim, calculated by its wide generalizations and ambiguous language to discourage further invention in the same department of industry and to cover antecedent inventions." (471-472)

"The specification of the reissued patent describes the burner of Reichmann substantially as was done in the original patent, being interspersed, however, with observations as to the uses and objects of particular parts, evidently borrowed from subsequent experience and events. The single claim of the original patent is expanded into seven distinct claims." (471)

"Our conclusion, therefore, is that the Comet burner is no infringement of Reichmann's reissued patent so far as that patent is valid." (473)

GILL v. WELLS, 89 U. S. 1 [1874]

Interval—8 years

Motive of Reissue—To alter the description and radically change a claim to dominate interim device. [This was a further reissue of a former reissue passed on in *Burr* v. *Buryee*, 68 U. S. 31]

Subject Matter—Hat body machine.

HELD

1.

"Exact description of the invention was given in the specification of the original patent, which affords the most ample means to define the nature and scope of the improvement actually made by the patentee as secured by that patent." (16)

"Instead of that it is unquestionably true that the chamber or tunnel is a material ingredient of the combination and an essential feature of the described invention." (18)

2.

"Invalid and inoperative patents may be surrendered and reissued for the same invention, but Congress never intended that a patent which was valid and operative should be reissued merely to afford the patentee an opportunity to expand the exclusive privileges which it secures, to enable him to suppress subsequent improvements which do not conflict with the invention described in the surrendered patent." (19)

"Attention will next be called to the specification of the reissued patent as the best means by which to determine whether the invention secured by it is or is not the same as that of the original." (21)

"Material matters are left out of the specification when compared with the original, and it is beyond dispute that new features are introduced in the description of the devices to be employed in guiding the fibres of the fur when taken from the feeding mechanism by the rotating brush or picker." (21)

"Differences so wide between an original and a reissued patent show that it was a bold measure to grant, as well as to ask for, such a reissue. Examples of the kind, if any, it is believed are very few in which such a reissued patent has been granted where there is not a word in the original specification to support the theory that the patentee ever invented anything except his described combination, which it is admitted consisted of four ingredients, all of which were old. Complete description is given in the original specification of that combination, but the specification does not contain the slightest evidence that the patentee ever made any other combination than that which embodies the four described ingredients.

Cases arise where a patentee, having invented a new and useful combination consisting of several ingredients which in combination compose an organized machine, also claims to have invented new and useful combinations of fewer numbers of the ingredients, and in such cases the law is well settled that if the several combinations are new and useful, and will severally produce new and useful results; the inventor is entitled to a patent for the several combinations, provided that he complies with the requirement of the Patent Act and files in the Patent Office a written description of each of the alleged new and useful combinations, and of the manner of making, constructing and using the same.

He may give the description of the several combinations in one specification, and in that event he can secure the full benefit of the exclusive right to each of the several inventions by separate claims referring back to the description in the specifications; and if by inadvertence, accident, or mistake, he should fail to claim any one of the described combinations, he may surrender the original patent and have a reissue not only for the combination or combinations

claimed in the original, but for any which were so omitted in the claims of the original patent.

Very different rules, however, apply in a case where the only invention described in the original patent is the one which includes all the ingredients of the machine, provided there is no suggestion, indication, or intimation that any other invention of any kind has been made." (23-24)

"Enough has already been remarked to show that all the principal claims of the original patent recognize the chamber or tunnel and its appendages as one of the primary ingredients of the patented invention, and it is absolutely certain that the specification of that patent contains neither suggestion, indication, nor intimation that the original patentee made any other invention to accomplish the described functions than the one which includes the whole four described ingredients." (27)

"Viewed in the light of these several suggestions the court is of the opinion that it is not competent for a patentee, when he surrenders an original patent, to amend the specification for the new patent by striking out from the original the correct description of one of the ingredients of the patented combination, and to substitute in its place the description of other devices not well known at the date of the original patent as a proper substitute for the ingredient whose description is stricken out." (30)

THE CORN-PLANTER PATENT, 90 U. S. 181 [1874]

Interval—5 years

Motive of Reissue—The original patent was divided into five reissues

Subject Matter—The Court considered the prior art and held certain valid and certain invalid. The original

disclosed a plow frame, a roller frame, a pivotal connection between them and levers to lift the plow. It claimed this combination narrowly.

HELD

"A proper decision of the questions in these causes renders it necessary, in the first place, to ascertain, as near as may be, the actual date of Brown's alleged invention or inventions, such as and whatever they are." (203)

"We have thus gone over and explained, as well as the subject will admit, the various machines and inventions which constitute the history of the special art under consideration, up to the time that Brown's machine was produced. In the light of this review we are to determine the extent and character of his various patents and claims, and how far they are valid or void." (216-217)

"It may be remarked in passing that, in our view, the several reissues are for things contained within the machines and apparatus described in the original patents; but whether they were anticipated by prior inventions, or are void for any other reason applicable to patents and claims generally, is still open." (217)

COLLAR COMPANY v. VAN DUSEN, 90 U. S. 530 [1874]

Interval—3 years

Motive of Reissue—To introduce and claim new matter.

Subject Matter—The original patent claimed a collar of parchment paper coated with varnish. After issuance, the patentee spent money and effort to obtain satisfactory paper not disclosed in the original. When

one company consulted produced the desired result, the patentee sold his patent and reissue was applied for. The reissue introduced in considerable length and detail specifications for the new paper. The reissue set forth that the paper may or may not be parchment and may or may not be coated with varnish. It claimed merely a collar of long fiber paper, as distinguished from the claim of the original which was limited to a collar of parchment paper with a coating of varnish. In appraising the patent, the Court considered the prior art.

HELD

"* * * the purpose of a surrender and reissue is not to introduce new features, ingredients, or devices, but to render effectual the actual invention for which the original patent should have been granted." (557-558)

"Whether a reissued patent is for the same invention as the surrendered original or for a different one, must very largely be determined by a comparison of the two instruments, as the decision must necessarily depend upon the question whether the specifications and drawings of the reissued patent are not substantially the same as those of the original; and if not, whether the omissions or additions are or are not greater than the law allows to cure the defects of the original specification." (558)

"Attempt was made in that case [*Gill v. Wells*] to emasculate the combination described in the original patent by leaving out one of the material elements in order to give the exclusive right a more comprehensive effect in prosecuting suits for infringement, but in the case before the court the reissued patent is different throughout from the invention embodied in the original patent." (559)

"Apply that rule to the present case and it is clear that the original patentee was not entitled to a patent either for the paper or the process, as he never made any invention or discovery upon the subject." (564)

THE WOOD-PAPER PATENT, 90 U. S. 566 [1873]

Interval—9 years

Motive for Reissue—To enlarge claim and dominate interim invention.

Subject Matter—The patents were for a process to obtain pulp from wood or other vegetable substances for the manufacture of paper.

HELD

Undeniably three successive stages of operation were described in the specification, three distinct processes, not employed contemporaneously, but following each other in order of time. And this succession in the order mentioned was considered by the patentees as essential, in fact it was claimed as their invention. In support of their application for the original American patent it was argued on their behalf that 'their invention relates to a series or combination of processes, in the order in which they are stated, for treating shavings, &c.' The several processes and their order was then stated. An 'order and series of processes' is what, according to the statement made in support of their application, 'constituted their invention, and what they supposed they had embodied in their claim.' And the claim of the patent was for the treatment of wood shavings by chemical agencies '*in the order* substantially as described.' How, then, is it possible to maintain that a process to obtain pulp by chemical action in a single operation had been invented by the patentees when their

first patent was granted? And what is of more importance, how is it possible to hold that such an invention was patented to them? We find no satisfactory evidence that the idea of a single-stage process was ever conceived by Watt & Burgess until after a patent disclosing it was granted to Marie Amedee Charles Mellier on the 26th day of May, 1857. This was before the surrender of their original patent, and before the reissue. And if Watt & Burgess had not invented the single-stage process, when their original patent was granted, the reissue 1449 is for a different invention from that described or referred to in the original patent; and such is the testimony of the experts who have been examined in this case. But the testimony of the experts is not needed. It appears on the face of the reissue that it is for a different invention, for the reissue is attempted to be sustained only on the ground that it is for a single-stage process. Both the reissues, therefore, we think, are void." (598-599)

RUSSELL v. DODGE, 93 U. S. 460 [1876]

Interval—6 months

Motive of Reissue—To change specification and enlarge claim beyond limits of novelty.

Subject Matter—The original patent was for a process of treating bark-tanned lamb or sheep skins by a compound including heated fat liquor. The reissue was for the use of fat liquor in the treatment of leather generally, and whether hot or cold.

HELD

"It is clear from this statement that the patent [reissue] is for the use of fat liquor in any condition, hot or cold, in the treatment of leather, and for a process of treating

bark-tanned lamb or sheep skin, by means of a compound in which fat liquor is the principal ingredient. The state of the liquor is not mentioned as essential to the treatment, or to accomplish any of the results sought. It is only stated as a thing to be desired, that the liquor should be heated, and that it would be preferable that other ingredients were mixed with the heated liquor to make the compound mentioned. In other words, the specification declares, that by heating the liquor the effect desired will be more readily produced; that is, more speedily or with less trouble and expense, not that the heating is in any respect essential to the treatment. Where a useful result is produced in any art, manufacture, or composition of matter by the use of certain means for which the inventor or discoverer obtains a patent, it is, as justly observed by the presiding justice of the Circuit Court, too plain for argument, that the means described must be the essential and absolutely necessary means, and not mere adjuncts which may be used or abandoned at pleasure.

The original patent was less extensive in its claim than the reissue. That patent was for a process of treating bark-tanned lamb or sheep skin by means of a compound, in which heated fat liquor was an essential ingredient. The specification was explicit in this particular, and left no doubt on the subject. The reissued patent covers the use of the fat liquor in any condition, hot or cold, and when used alone or in a compound with other ingredients, and thus has a more extended operation, bringing under it manufactures not originally contemplated by the patentee. Is such a reissue valid?" (462-3)

"A defective specification could be rendered more definite and certain so as to embrace the claim made, or the claim could be so modified as to correspond with the specification; but except under special circumstances, such as occurred in the case of *Lockwood* v. *Morey*, 8 Wall. 230,

where the inventor was induced to limit his claim by the mistake of the Commissioner of Patents, this was the extent to which the operation of the original patent could be changed by the reissue. The object of the law was to enable patentees to remedy accidental mistakes, and the law was perverted when any other end was secured by the reissue.

Judged by that law,—and the provisions of the act of 1870 on this subject are substantially the same,—there can be no doubt of the invalidity of the reissue. The original patent was not inoperative nor invalid from any defective or insufficient specification. The description given of the process claimed was, as stated by the patentee, full, clear, and exact, and the claim covered the specification; the one corresponded with the other. The change made in the old specification, by eliminating the necessity of using the fat liquor in a heated condition, and making in the new specification its use in that condition a mere matter of convenience, and the insertion of an independent claim for the use of fat liquor in the treatment of leather generally, operated to enlarge the character and scope of the invention. The evident object of the patentee in seeking a reissue was not to correct any defects in specification or claim, but to change both, and thus obtain, in fact, a patent for a different invention. This result the law, as we have seen, does not permit." (463-464)

"But, assuming that the reissue is not void for the reasons stated, the patent is still invalid for want of novelty in the alleged invention. The use of fat liquor in the treatment of bark-tanned skins was general with manufacturers for many years previous to the alleged invention." (465)

SMITH v. GOODYEAR DENTAL VULCANITE COMPANY,
93 U. S. 486 [1870]

Interval—8 months

Motive of Reissue—To enlarge the claim to dominate interim devices.

Subject Matter—Denture.

HELD

"A brief review of the history and nature of the patent which the complainants allege has been infringed will aid materially in solving the questions presented by this appeal." (489)

"It is further insisted by the defendant that the reissued patent on which this suit is founded is not a patent for the same invention which was described in the specification of the original patent, and, therefore, that the reissue is unauthorized and void. To sustain this position the defendant must overcome the presumption against him arising from the decision of the Commissioner of Patents in granting the issue; and this he can do only by showing, from a comparison of the original specification with that of the reissue, that the former does not substantially describe what is described and claimed in the latter. This must plainly appear before we can be justified in pronouncing the reissued patent void. But this, in our judgment, does not appear. The first specification describes a set of artificial teeth having a hard-rubber plate made by a process substantially the same as that indicated in the later patent. The description of the process is not quite so minute; but it is sufficiently full to be understood, and to enable an operator to make the manufacture. Certainly it is not another process; and as its result is the same, it is impossible to hold that the reissued patent is for a different invention from the one protected by the original patent." (499-500)

KEYSTONE BRIDGE CO. v. PHOENIX IRON CO.,
95 U. S. 274 [1877]

Subject Matter—This was a decision on an original patent but, in passing on scope, the Court announced the rule that in a proper case a broadened reissue may be valid.

HELD

"Here, again, the patentees clearly confine themselves to *'wide and thin'* bars. They claim the use in truss bridges of such bars when the ends are upset and widened in the manner described. It is plain, therefore, that the defendant company, which does not make said bars at all, but round or cylindrical bars, does not infringe this claim of the patent. When a claim is so explicit, the courts cannot alter or enlarge it. If the patentees had not claimed the whole of their invention, and the omission has been the result of inadvertence, they should have sought to correct the error by a surrender of their patent and an application for a reissue." (278)

GLUE COMPANY v. UPTON, 97 U. S. 3 [1877]

Interval—6 years

Motive of Reissue—Not stated.

Subject Matter—The patent was held invalid for lack of patentable subject matter. The Court did not pass on the defenses of whether the reissue was for the same invention as the original; but it is indicated that the test of such question would be whether the reissue differed in any substantial particular.

HELD

"We shall treat the reissue as for the same invention or discovery, differing in no substantial particular from that originally patented." (4)

MARSH v. SEYMOUR, 97 U. S. 348 [1877]

Interval—10 years

Motive of Reissue—Not stated.

Subject Matter—Three reissues for reaping and harvesting machines were involved of which two had been passed on in *Seymour* v. *Osborne*, 78 U. S. 516. In order to pass on the defenses the Court first considered the rank of the inventions in view of the prior art.

HELD

"Patents, in a proper case, may be surrendered and reissued, but the reissued patent must be for the same invention as the original patent, else the reissue is invalid; but the patentee may redescribe his invention, and include in the description and claims of the specification not only what was well described before, but whatever else was suggested or substantially indicated in the old specification, drawings, or patent-office model, which properly belonged to the invention as actually made and perfected. Corrections may be made in the description, specification, or claims of the patent where the patentee has claimed as new more than he had a right to claim, or where the description, specification, or claim is defective or insufficient; but he cannot, under such an application, make material additions to the invention which were not described, suggested, nor substantially indicated in the original specifications, drawings, or patent-office model." (355-356)

RAILWAY CO. v. SAYLES, 97 U. S. 554 [1878]

Subject Matter—This was a decision on an original patent which, however, had been substantially modified before issuance. The Court held non-infringement, but re-

ferred to the analogy between amendments to an original application and the amendments of original patents by reissue.

HELD

"* * * if the amended application and model, filed by Tanner five years later, embodied any material addition to or variance from the original,—anything new that was not comprised in that,—such addition or variance cannot be sustained on the original application. The law does not permit such enlargements of an original specification, which would interfere with other inventors who have entered the field in the meantime, any more than it does in the case of reissues of patents previously granted. Courts should regard with jealousy and disfavor any attempts to enlarge the scope of an application once filed, or of a patent once granted, the effect of which would be to enable the patentee to appropriate other inventions made prior to such alteration, or to appropriate that which has, in the meantime, gone into public use." (563-564)

HYNDMAN v. ROOTS, 97 U. S. 224 [1877]

Interval—11 months

Motive of Reissue—Not stated.

Subject Matter—Structure of Rotary Blowers.

HELD

"The answer denies * * * that the reissue is for the same thing as the original patent; * * *

Such were the issues made by the appellant in the court below. That Court found all of them in favor of the appellees, and decreed accordingly. * * * The questions are questions of fact. No legal proposition is involved." (226-27)

BATES v. COE, 98 U. S. 31 [1878]

Interval—4 years

Motive of Reissue—Not stated.

Subject Matter—Drilling and bolt-tapping machine.

HELD

"In determining about similarities and differences, courts of justice are not governed merely by the names of things; but they look at the machines and their devices in the light of what they do, or what office or function they perform, and how they perform it, and find that a thing is substantially the same as another, if it performs substantially the same function or office in substantially the same way to obtain substantially the same result; and that devices are substantially different when they perform different duties in a substantially different way, or produce substantially a different result." (42)

POWDER COMPANY v. POWDER WORKS, 98 U. S. 126 [1878]

Interval—7 years

Motive of Reissue—Not stated.

Subject Matter—The original was for a process of exploding nitro-glycerine. The reissues were for mixtures and compositions.

HELD

"If it were a case in which the identity or non-identity of the inventions in the original and reissued patents was a complicated question, the court might require the defendants to answer, in order to have the benefit of evidence on the subject." (134)

"Now, in all this specification there is not a hint of any new mixture or new composition of matter having been invented by the patentee." (135)

"Inasmuch as the reissued patents in question, numbered 4818 and 4819, are for compounds of nitro-glycerine with various other substances, it is impossible not to say that they are for an entirely different invention from that secured, or attempted to be secured, by the original patent. If the patent had been not for the mode or process of exploding nitro-glycerine, but for the process of compounding nitro-glycerine with gunpowder and other substances, inadvertently omitting to claim the exclusive use of the substances so produced, the case would have been one of very different consideration. That was the case with Goodyear's patent, which was issued in 1844, and claimed only the process of vulcanizing india rubber. In 1849 it was surrendered, and two new patents issued in lieu thereof,—one for the process, and the other for the composition. In 1852, the validity of these reissues came up for consideration in the third circuit, in the case of *Goodyear* v. *Day*, which was argued by Mr. Choate, Mr. Webster, and other eminent counsel. Mr. Justice Grier disposed of the objections as follows: 'We now come to the objections which have been made to the reissued or amended patents of 1849. The first objection is that the patents of 1844 and 1849 are not for the same invention. This objection is not founded in fact. Both patents are for precisely the same invention or discovery. They both describe, in nearly the same words, the best mode of manufacturing india-rubber, by exposing it to a high degree of heat in connection with sulphur and white lead; by which treatment the substance is endowed with new and valuable qualities which it did not possess before. The discovery is the same; the mode of manufacturing the compound is the same. The first patent had set forth the nature and extent of the invention defec-

tively. There is no reason to doubt the *bona fides* and propriety of the reissue. It is apparent on the face of the papers, even if the action of the commissioner on that point was not conclusive.' Again, he adds: 'The fourth objection is 'that the latter patent claims more than was contained in the original.' If the latter patent is for precisely the same invention, art, or discovery as that described in the first, the objection that it claims more is a mistake of fact. If the last patent differs from the first only in stating more clearly and definitely the real principles of the invention, so that those who wish to pirate it may not be allowed to escape with impunity through the imperfection of the language used in the first, there has arisen one of the cases for which it was the intention of the act of Congress to provide, and the objection is worthless in point of law.' This case is partially reported in 2 Wall. Jr. 283, but the opinion of Mr. Justice Grier is not stated in full." (136-137)

"The present case is entirely different. The processes which the patentee described as his invention in the original patent, No. 50,617, had no connection with the compounds or mixtures which are patented in the reissued patents. They were not processes for making those compounds, and in describing them the compounds were not mentioned. The invention of the one did not involve the invention of the other. The two inventions might have been made by different persons, and at different times.

We think, therefore, that the conclusion is irresistible, that the two reissued patents, numbered 4818 and 4819, are for a different invention from that described or suggested in the original patent No. 50,617, upon which they are founded, and which they are intended, in part, to supersede." (137)

"The specification may be amended so as to make it more clear and distinct; the claim may be modified so as to make

it more conformable to the exact rights of the patentee; but the invention must be the same. So particular is the law on this subject, that it is declared that 'no new matter shall be introduced into the specification'. This prohibition is general, relating to all patents; and by 'new matter' we suppose to be meant new substantive matter, such as would have the effect of changing the invention, or of introducing what might be the subject of another application for a patent. The danger to be provided against was the temptation to amend a patent so as to cover improvements which might have come into use, or might have been invented by others, after its issue." (138)

"It does not authorize him to grant a reissue for a different invention, or to determine that one invention is the same as another and different one; or that two inventions essentially distinct constitute but one." (138-139)

WATER-METER COMPANY v. DESPER, 101 U. S. 332 [1879]

Interval—4 years

Motive of Reissue—To enlarge claim to dominate interim device.

Subject Matter—The original patent covered a combination of particular elements making up a water meter having two parallel cylinders each traversed by two connected pistons, a shaft with a crank at each end extended from one piston rod to the other. The defendant's water meter omitted the shaft with its two cranks, pinion and gearing.

HELD

"The meter manufactured by the defendants is different in several respects from that described in the complainant's patent. It has a rotary valve like the latter, but

without any bevel-gear; it also has two cylinders, with an immaterial difference of position, being placed at right angles with each other instead of being parallel; each cylinder is likewise provided with two double-acting pistons, connected by a piston-rod, the same as in the complainant's meter; the cylinder-heads are also furnished with Ericsson's stops projecting inside for arresting the movement of the pistons, though these stops are fixed and not adjustable. But the meter of the defendant's has no crank-shaft, and no semblance of a crank-shaft, for imparting motion from the pistons to the rotary valve; on the contrary, their valve is connected directly with the piston-rods in the following manner: The piston-rods cross each other at right angles, having transverse slots, and being halved together, one lying immediately on the other, so that the axes of the pistons are in the same plane. The valve below is connected directly with the piston-rods by a single crank which is keyed on to its upper solid stem, and has a crank-pin which works in the two slots of the respective piston-rods. Thus arranged, the successive reciprocating movements of the two double pistons impart a circular motion to the valve, which, by duly arranged induction and eduction ports, alternately fills and empties the respective cylinders.

From this it appears that, in the construction of defendants' meter, the crank-shaft, with its two cranks, pinion, and gearing connection (which is an essential feature of the complainant's meter), is altogether dispensed with. The defendants effect the desired result of communicating rotary motion to the valve without any such shaft, or any thing equivalent thereto. The entire part, with all its appurtenances, is thrown out of their machine. They use a crank, it is true; but it is attached directly to the rotary valve, and is a part of it. The use of a crank in converting reciprocating into rotary motion is an old device. It was applied to the steam-engine a century ago, and has been

applied to hundreds of different machines since that time. Ball and Fitts had no claim to it, but only to the particular method and device by which they employed it, in combination with the various other parts of their meter. Instead of the crank-shaft, had they in their patented combination claimed every method, and all methods, of communicating motion from the piston-rods to the rotary valve by means of a crank, the defendants' meter would have been an infringement. But such a claim might not have been valid. At all events, it was not allowed.

The specification was evidently drawn with great care, and it is to be presumed that the patentees claimed all that the Patent Office considered them entitled to. We cannot say that the crank-shaft was an immaterial part of their combination. The patent, as it stands, occupies very narrow ground. It requires the presence of every one of the elements specified in the combination secured by it. We think that the defendants do not use all of these elements, but that they dispense with one of them at least which is material in the complainant's meter. Our conclusion, therefore, is, that they do not infringe the complainant's patent." (335-337)

BALL v. LANGLES, 102 U. S. 128 [1880]

Interval—13 years

Motive of Reissue—To change disclosure and claim to cover interim devices.

Subject Matter—The original was for a cooking oven constructed so that the combustion products could not be passed through it.

HELD

"The commissioner was invested with authority to determine whether the surrendered patent was valid by reason

of a defective or insufficient specification, or because the patentee had claimed more than he had a right to claim as new; and if he found such to be the case, and found also that the error had been due to inadvertence, accident, or mistake, without fraud, his decision was conclusive, and not subject to review by the courts. But the law did not confer upon him jurisdiction to grant a reissue embracing new matter, or a broader invention than what was revealed by the original specification, or drawings or models, except in some cases where there was neither model nor drawing. A reissue for anything more is, therefore, inoperative and void. Accordingly, this court has repeatedly held that if, on comparing a reissue with its original, the former appears on its face to be for a different invention from that described or indicated in the latter, it must be declared invalid." (129-130)

"If, now, we turn to the reissues of 1869 and 1870, it cannot be doubted that while they claim what was claimed in the original, they claim much more. They claim an entirely different mode of heating the chamber, necessitating a radical difference in the construction of the oven.

The specification of the reissue of 1870, as well as that of 1869, instead of representing the space above the fire-chamber as communicating with the interior chamber only indirectly through perforations in the vertical and back flues, described it as communicating 'directly or indirectly in any proper manner with the chamber in which the bread-receiving shelves or platforms are revolved.'" (131)

"Thus his reissued patent has become one for an oven in which there may be no diaphragm or partition separating the compartment in which the dough is placed from the furnace by which it is heated, and which may be directly under it. Thus the oven is made a part of the passageway for the products of combustion from the fire-chamber to the chimney. That this is a very different invention from

anything exhibited in the original specification and drawings is too obvious to need further elucidation. We cannot doubt that the purpose of the reissues was not to cure defects in the original specification, or any deficiency in describing the invention, but to cover other devices which the patentee had not in mind when he first applied for his patent, and which may have subsequently come to his knowledge. Thirteen years after the patent was granted had elapsed before he applied for any reissue. However this may be, the reissued letters are so clearly for a different invention from that for which the patentee first applied, containing new matter, and so much broader, that we are constrained to hold that the Commissioner of Patents had no authority to grant them, and consequently that they are void." (132)

GARNEAU v. DOZIER, 102 U. S. 230 [1880]

Interval—15 years

Motive of Reissue—To cover materially efficient interim device.

Subject Matter—The reissue patent held invalid in *Ball* v. *Langles*, 102 U. S. 128, was again in issue and the ruling of invalidity adhered to. Another reissue patent was also involved, which was held non-infringed.

HELD

"To determine accurately the extent of the invention secured by this patent, the state of the art at the time when the original patent was granted (May 1, 1860) must be considered. Before that time, ovens were well known, and they had been constructed with a baking-chamber, a fireplace or furnace (one or more) arranged immediately under the chamber, and with a rotating reel located within

the chamber, and revolving around a horizontal shaft, the reel provided with gravitating shelves or pans suspended on rods attached to its arms. Some of these ovens were arranged so that a portion of the heated products of combustion should pass into and through the baking-chamber, though indirectly by a circuitous route." (234)

"It is obvious, therefore, that if the McKenzie patent can be sustained at all, it must receive a very limited construction." (234)

MANUFACTURING COMPANY v. LADD, 102 U. S. 408 [1880]

Interval—12 years

Motive of Reissue—To enlarge for dominating interim devices.

Subject Matter—The original patent was for a water wheel of specific construction and form with its associated apparatus.

HELD

"It was conceded that if the reissued patent should be construed literally, without restraining the generality of its claims by a reference to the original patent, the wheels made by the defendant would be an infringement; but the court, in view of the state of the art at the date of Swain's invention, and of the distinct limitation of that invention in the original patent to a wheel of specific construction and form, considered itself bound to construe the claims of the reissued patent in accordance with such limitation, in order to avoid the conclusion that it was for another and different invention from that originally patented. From a careful examination of the evidence in the case we are satisfied that this was the most favorable view that could have been

taken for the complainant. A comparison of the original letters-patent, including the drawings and model, with the reissued patent, makes it very evident that the latter is the result of an effort to enlarge the scope of the patent so as to include and embrace within it matters and things that were not embraced in the original invention. The original specification, drawings, and model all agree in describing a specific wheel and associated apparatus as the subject of the invention secured by the letters-patent." (409-410)

"But a change comes over the scene: the patent becomes the property of a corporation that manufactures wheels; a monopoly of the business is very desirable; other manufacturers make turbine wheels approaching somewhat in appearance to that described in Swain's patent. The usual remedy in such cases is resorted to. A reissue of the patent is sought, with expanded claims, sufficiently general and comprehensive to embrace a wide monopoly of structure, and to shut up competing establishments." (411)

"In a clear case of mistake—not error in judgment—the patent may undoubtedly be enlarged; but that should be the exception, not the rule; whereas the enlargement of claims has become the rule, and their contraction the exception." (411)

"The patentee desires to secure the monopoly of every centrevent wheel, of whatever shape or form, which discharges the water both inwardly in the centre of the wheel and downwardly from the bottoms of the floats beneath the wheel. But that would be a new invention, very different from what was described and claimed in the original patent. To warrant this extension of the claim, the specification of the reissued patent contains material variations from that of the original, frequently stating that a particular part *may* be constructed thus and so, when the original *required* it to be thus and so; it speaks of "the upper hori-

zontal edge of the floats," when no such thing is mentioned in the original, but on the contrary the rim over the floats was described as curving inward and downward, and as being so curved for a special purpose and effect. Instead of correcting inadvertent mistakes in the specification, which rendered the patent inoperative and void, the pretended corrections are evidently intended to widen the scope of the patent, and to make it embrace more than it did at first. So far as description went, the original specification was as perfect as the new one." (412-413)

"If the appellant insists on the broad construction of the claims in the new patent, it must take the risk of being met with previous achievements in the same line of improvement, which may very seriously endanger the validity of its patent. Several structures have been produced on the hearing, antedating the invention of Swain, and it would be very difficult to maintain that they do not embrace the principal feature in Swain's wheel, sought to be appropriated by him." (414)

MANUFACTURING COMPANY v. CORBIN, 103 U. S. 786 [1880]

Interval—6 years

Motive of Reissue—To change materially the claimed device.

Subject Matter—The original patent was for a window sash lock and narrowly claimed a combination of six elements. The reissue broadly claimed a combination of three elements, which was not the invention of the joint inventors, but of one of them solely for which he had earlier and separately applied for a patent which was refused for lack of novelty.

HELD

"The essential distinction between the original invention of Voll, for which letters were refused, and that covered by the reissue to the appellant, is this: In the contrivance first named the locking lever when in locked position was held fast in its place by a bolt which was driven by a spiral spring into a hole in the stump on which the lever was pivoted. In the contrivance covered by the letters to Voll and McGregor the bolt which holds the locking lever in its place, instead of entering a hole in the post, is forced by the spiral spring past the end of a segment raised upon a base plate, which prevents a sidewise movement of the locking lever until the bolt is retracted.

The sash lock manufactured by appellees, which appellant alleged was an infringement of its reissued letters, had placed on the end of the locking lever a pivoted latch provided with a downward projection, which, when the locking lever was placed in a locking position, entered a hole or socket in the base plate.

The court below dismissed the bill. Its decree is brought here for review.

The defence insisted on is that if the claim of the appellant's reissued letters be construed to cover the appellees' sash locks, it is void, because it embraces the previous invention made by Voll alone, which had been abandoned to the public after it had been rejected by the Patent Office, and which was not the invention of Voll and McGregor jointly, and that if the reissue is so construed as to cover the sash locks made by the appellees, it is for a different invention from that which the original letters to Voll and McGregor covered." (789-790)

"Conclusive evidence to establish the defence is found in the amendments made by the appellant in its application for reissue. If the reissue had been granted as applied for, it might with some plausibility have been claimed that the

reissued letters were infringed by the sash locks made by the appellees. But the application in its original form was not granted. The specification for the reissue was amended by striking out, wherever they occurred, the words 'socket or depression in the base plate,' and substituting the words 'catch segment or segment.'

This shows beyond controversy that in asking for a reissue the appellant sought to make its letters cover sash locks like those made by the appellees, but was not able to do so, and the reissue was restricted to a sash lock in which the locking lever was made fast by a bolt driven past the end of a segment raised on the base plate." (791)

MILLER v. BRASS CO., 104 U. S. 350 [1881]

Interval—16 years

Motive of Reissue—To broaden dominate interim devices.

Subject Matter—The patent was for a kerosene lamp burner and claimed a combination of devices including two reflectors elevated above a perforated cap enclosing a wick tube and dispensed with the need of a chimney.

HELD

"The invention proved a failure, but it was found that the use of one of the domes (and the other parts), with the restoration of the chimney, would be a real improvement, and both the complainant and the defendant made such lamps in large quantities. Fifteen years after the original patent was granted, the patentee (or rather his assignee) discovers that the improved lamp was really a part of his original invention, and that by inadvertence and mistake he had omitted to claim it. We think, however, that the court below was clearly right in holding that the invention specified in the second claim of the reissued

patent (which is the one in question here) is not the same invention which was described and claimed in the original patent. The latter was for a double dome without a chimney, the peculiarity of the supposed invention being the use of the double dome as a means of dispensing with the chimney. The reissue is for a single dome with a chimney. It is not only obviously a different thing, but it is the very thing which the patentee professed to avoid and dispense with.

But there is another grave objection to the validity of the reissued patent in this case. It is manifest on the face of the patent, when compared with the original, that the suggestion of inadvertence and mistake in the specification was a mere pretense; or if not a pretense, the mistake was so obvious as to be instantly discernible on opening the letters-patent, and the right to have it corrected was abandoned and lost by unreasonable delay. The only mistake suggested is, that the claim was not as broad as it might have been. This mistake, if it was a mistake, was apparent upon the first inspection of the patent, and if any correction was desired, it should have been applied for immediately.

These afterthoughts, developed by the subsequent course of improvement, and intended, by an expansion of claims, to sweep into one net all the appliances necessary to monopolize a profitable manufacture, are obnoxious to grave animadversion. The pretense in this case that there was an inadvertence and oversight which had escaped the notice of the patentee for fifteen years is too bald for human credence. He simply appealed from the judgment of the office in 1860 to its judgment in 1876; from the commissioner and examiners of that date, to the commissioner and examiners of this; and upon a matter that was obvious on the first inspection of the patent. If a patentee who has no corrections to suggest in his specification except to make his claim broader and more comprehensive, uses due diligence in returning to the Patent Office, and says, 'I omitted

this,' or 'my solicitor did not understand that,' his application may be entertained, and, on a proper showing, correction may be made." (351-352)

"At all events, we think it clear that it was not the special purpose of the legislation on this subject to authorize the surrender of patents for the purpose of reissuing them with broader and more comprehensive claims, although, under the general terms of the law, such a reissue may be made where it clearly appears that an actual mistake has inadvertently been made. But by a curious misapplication of the law it has come to be principally resorted to for the purpose of enlarging and expanding patent claims. And the evils which have grown from the practice have assumed large proportions. Patents have been so expanded and idealized, years after their first issue, that hundreds and thousands of mechanics and manufacturers, who had just reason to suppose that the field of action was open, have been obliged to discontinue their employments, or to pay an enormous tax for continuing them.

Now whilst, as before stated, we do not deny that a claim may be enlarged in a reissued patent, we are of opinion that this can only be done when an actual mistake has occurred; not from a mere error of judgment (for that may be rectified by appeal), but a real *bona fide* mistake, inadvertently committed; such as a Court of Chancery, in cases within its ordinary jurisdiction, would correct. Reissues for the enlargement of claims should be the exception and not the rule." (354-355)

JAMES v. CAMPBELL, 104 U. S. 356 [1881]

Interval—7 years

Motive of Reissue—To broaden to cover interim device.

Subject Matter—The original patent dealt with a postage cancelling stamp and narrowly claimed a particular

structure of a post marking stamp and cancelling stamp. The reissue claimed the broad cancelling stamp alone and the broad cancelling stamp with any post marking stamp.

HELD.

"The government of the United States, as well as the citizen, is subject to the Constitution; and when it grants a patent the grantee is entitled to it as a matter of right, and does not receive it, as was originally supposed to be the case in England, as a matter of grace and favor." (358)

"It will be seen that the invention claimed is very specific and definite in its character." (361)

"It is plain, therefore, that elasticity in the material of which the blotter was to be composed was a distinctive feature of the blotting device thus separately claimed." (362)

"It was not without good cause, therefore, that the separate claim for the cancelling device, as a distinct invention, was confined to an elastic type or blotter enclosed in a hollow tube." (362)

"The evidence does not show to our satisfaction that Norton was by any means the first inventor of a double post-office stamp, so constructed as to make the post-mark and cancel the postage-stamp at one blow." (363)

"Now, there is abundant evidence in the record to show that double stamps were conceived of and used before 1859, and that about that time they sprung up spontaneously in various parts of the country." (367)

"No one can read the patent in the light of these contemporary documents, and of the previous history of the stamp,

without arriving at the conclusion that, so far as the blotting device was separately concerned, the invention consisted of, and was confined to, a tube containing a type-blotter made of an elastic substance, as contradistinguished from iron or other hard substance. The iron or steel blotter had been patented in 1862, as already mentioned, and as will be shown more fully hereafter. There was not, there could not have been, any inadvertence or mistake in confining the invention to the combination described and claimed in the patent." (369-370)

"Of course, if, by actual inadvertence, accident, or mistake, innocently committed, the claim does not fully assert or define the patentee's right in the invention specified in the patent, a speedy application for its correction, before adverse rights have accrued, may be granted, as we have explained in the recent case of *Miller* v. *Brass Company*, *supra*, p. 350. But where it is apparent on the face of the patent, or by contemporary records, that no such inadvertence, accident, or mistake, as claimed in a reissue of it, could have occurred, an expansion of the claim cannot be allowed or sustained." (371)

"By these extracts from the specification, and the summary of claims, it appears perfectly obvious that the patentee has embraced in the reissued patent several matters of supposed invention different from and additional to the invention which formed the subject of the original patent. And it is principally, if not wholly, these new and additional claims which the appellant James, as postmaster of New York, is charged with infringing.

In the first place, a new form of the cancelling device is set forth and claimed, different from that described in the original patent, to wit, a cancelling type or die attached directly to the cross-bar, without any tube or pipe surrounding and holding the same. This is not contemplated or hinted at in the original patent." (374)

"Not a hint was given that the cylinder could be dispensed with. This was an after-thought. The cylinder was clearly and distinctly set forth as a necessary constituent of the device, and an essential element in the combination of which the blotting device consisted.

The bearing which this new feature in the reissued patent has on the case is evinced by the fact that one of the devices used for several years in the post-office, which is complained of as an infringement of the patent, was a naked blotter made of cork, directly attached to the cross-bar, without any enclosing cylinder to support it; also by the fact that the other device used in the post-office during the defendant's term of office consisted of an iron blotter directly attached to the side of the postmarking stamp without any enclosing cylinder.

In our judgment this addition to the patent was no part of the original invention, and could not lawfully be embraced in the reissue, and that the claim for it is therefore void." (375)

"This language amounts to an express disclaimer of solid metal." (376)

"How, after this, it could be supposed that the use of solid metal as a material for the type-blotter was included in the invention, and that a claim for it was omitted through inadvertence and mistake, it is difficult to understand." (376)

HEALD v. RICE, 104 U. S. 737 [1881]

Interval—1 year, 5 months

Motive of Reissue—To broaden and cover new matter.

Subject Matter—The patents related to a straw burning furnace comprising a return-flue boiler. The reissue was for the combination of another inventor's straw feeding device with the boiler.

HELD

"In the present case the question of the identity of the invention in the original and reissued patents is to be determined from their face by mere comparison, notwithstanding what was said in *Battin* v. *Taggert* (17 How. 74), and consistently with *Bischoff* v. *Wethered* (9 Wall. 812), according to the rule laid down in *Seymour* v. *Osborne* (11 Wall. 516), and *Powder Company* v. *Powder Works, supra.* That is, if it appears from the face of the instruments that extrinsic evidence is not needed to explain terms of art, or to apply the descriptions to the subject-matter, so that the court is able from mere comparison to say what is the invention described in each, and to affirm from such mere comparison that the inventions are not the same, but different, then the question of identity is one of pure construction, and not of evidence, and consequently is matter of law for the court, without any auxiliary matter of fact to be passed upon by a jury, if the action be at law." (749)

"It appears, then, from the mere reading of the two specifications, that the invention described in the first is for the return-flue boiler; while that described in the second, abandoning the claim for the boiler itself, is for a particular mode of using it, with straw as a fuel, by means of an attachment to the furnace-door for that purpose. It might well be that Rice was entitled to patents for both, separately, or to one for both inventions. But it is too plain for argument that they are perfectly distinct. A patent, consequently, originally issued for one cannot lawfully be surrendered as the basis for a reissue for the other." (753)

"The second principal objection to the validity of the Rice reissued patent is, that it is anticipated by the Morey patents. We are of opinion that it also is well taken." (753)

MATHEWS v. MACHINE COMPANY, 105 U. S. 54 [1881]

Interval—14 years

Motive of Reissue—To cover wide departure in structure from original invention.

Subject Matter—The original patent was for a construction of a fire hydrant with the surrounding connected casing. The reissue changed the disclosure of the casing and altered its function. The reissue was condemned on account of the 14 years' delay and also on account of divergence of invention.

HELD

"There is still another objection to the claims in question. There is a wide departure from the original invention in this, that the subject of the latter was a jacket, or casing, whose top was enclosed and covered by a flange projecting from the hydrant, which effectually prevented the removal of the jacket without removing the hydrant also; and which caused the hydrant to be raised when the jacket was lifted by the frost. In the reissued patent nothing is said of this arrangement of the top of the jacket, and the claims ignore it altogether; so that, as already intimated, the patent as it now stands would cover such a jacket as that described and claimed in the complainants' patent of 1869, which slides like a sleeve over the hydrant at top as well as bottom. The reissue is not only for a broader claim made many years after the original was granted, but is for a different invention. Therefore, so far as the jacket is concerned, we think it cannot be sustained." (58)

BANTZ v. FRANTZ, 105 U. S. 160 [1881]

Interval—14 years

Motive of Reissue—To claim separately elements originally claimed as combination.

Subject Matter—The original narrowly claimed a combination of eight elements in a wet fuel furnace. The reissue claimed several of the parts separately.

HELD

"It is evident, therefore, that if the appellant had, in his application for the original patent, claimed as his own invention all the distinct devices described in the specification, he could not have obtained his patent in its present form. It could have been only on the ground that his claim was for a combination that it was allowed and the patent issued." (165)

"In this case the original patent bears date June 22, 1858. The reissue bears date Feb. 6, 1872, more than thirteen years and six months after the date, and less than five months before the expiration, of the original patent. If the specification in the original patent was defective or insufficient in claiming a combination of several devices instead of making a distinct claim for every device which entered into the combination, the fact was instantly discernible, even to an unpractised eye, as soon as the patent was read. Therefore, as said by Mr. Justice Bradley in delivering the opinion of this court in a similar case, *Miller v. Brass Company* (104 U. S. 350), if any correction was desired it should have been applied for immediately; the right to have the correction made was abandoned and lost by unreasonable delay. That case is apposite and is conclusive of this." (165-166)

JOHNSON v. RAILROAD CO., 105 U. S. 539 [1881]

Interval—15 years

Motive of Reissue—To enlarge the claim to dominate interim device.

Subject Matter—The original patent showed and claimed a self-adjusting fastener for attaching metal roofs to buildings. The reissue broadly claimed a sub-combination used in connecting railway rails together.

HELD

"It takes but slight comparison of the patents to show that this contention is well founded. The original patent was for a complicated contrivance, consisting of a number of old devices combined, and specially adapted to the fastening of metallic coverings to buildings, and for use in all other places where metals require fastening and their contraction and expansion require accommodation. To make the invention of any practical value for the purpose suggested in the specification, and for use in the 'other places' referred to, all the parts of the device therein described, except, perhaps, the rubber cord, which is only for temporary use in applying the device, are absolutely essential. Nowhere in the specification is it indicated or suggested that any part of the device described can be dispensed with. It is perfectly clear that the stud and bottom-plate of the contrivance are absolutely necessary to the only specific use mentioned in the specification. If these are left out there is no connection between the two materials to be fastened together; namely, the metal roof and the wooden sheathing under it. As the declared purpose of the invention is the fastening of these two materials together, it is difficult to see how the parts of the device essential to the fastening can be discarded, and the invention still remain perfect and unchanged." (545-546)

"Under the original patent the materials or things to be fastened together are the metallic covering of the roof and the under surface of the wooden sheathing on which it is laid. The slotted plates or flanges are fastened to the under side of the sheathing by the bottom-plate, which connects the flanges, and they form a support for the adjusting-bolt; but the slotted flanges do not embrace or clamp any part of the wooden sheathing or any part of the metallic covering of the roof, much less do they embrace or clamp at the same time the sheathing and the metallic covering, which are the things to be fastened together. But in the reissued patent the slotted plates not only furnish bearings for the bolt, but perform a new and essential function, of furnishing a strong lateral support to the materials to be fastened together by clamping the same between them.

We find, therefore, that in the reissued patent several of the devices essential to the combination described in the original patent are left out and a separate claim made for the parts which remain, and to these parts a new and essential function is given, which they could not perform under the original patent.

It is, therefore, perfectly clear that the second claim of the reissued patent was not covered by the original patent. It describes another device operating in a different way and for a different purpose." (546-547)

"There was no error in the original patent caused by inadvertence, accident, or mistake, which could have escaped the notice of the patentee and his associates for fifteen years. It is not open to dispute that the fish-plate joint, precisely such as the appellants claim is covered by their reissued patent, was in general use during nearly the entire life of the original patent. Why did not the patentee earlier discover that all this use of the fish-plate joint was really an infringement on his patent and apply for a reissue and assert his rights? He has rested supinely until the use of the fish-plate joint has become universal, and then, after

a lapse of fifteen years, has attempted by a reissue to extend his patent to cover it. We think it is perfectly clear that the original patent could not be fairly construed to embrace the device used by the appellee, which appellants insist is covered by their reissue. If the reissued patent covers it, it is broader than the original, and is, therefore, void. *Giant Powder Co. v. Cal. Vigorit Powder Co.*, 6 Sawyer, 508; *Powder Company v. Powder Works*, 98 U. S. 126; *Ball v. Langles*, 102 id. 128; *James v. Campbell*, 104 id. 356.

Even if the patentee had the right to a reissue if applied for in seasonable time, he has lost it by his laches and unreasonable delay. *Miller v. Brass Company*, id. 350.

The defense of want of novelty set up in the answer is, in our opinion, also sustained by the evidence." (547)

GOSLING v. ROBERTS, 106 U. S. 39 [1882]

Interval—6 years

Motive of Reissue—To enlarge disclosure and claim to dominate interim device.

Subject Matter—The original patent was for a flexible plate connected at the top to a carriage door and at the bottom to the carriage step. The reissue made at least six recited changes in the original disclosure to arrive at a claim for a plate not held at its bottom to the step. Any scope of the reissue claim to cover defendant's device also made it invalid for lack of novelty.

HELD

"Accordingly, the reissue makes the statement, not found in the original, that the important feature of the invention is to have the plate attached to the door, and thus operate as a step-cover and a wheel-fender. The first claim of the

reissue is not found in the original, and grows out of the changes above mentioned. It is a broad claim to a combination with the step and the door of the plate E attached to the door, to operate as a step-cover and a wheel-fender, substantially as and for the purpose specified." (45)

"There is no difference in principle or mode of operation between the old structures and the defendant's structure. The difference is merely in form and shape. The plaintiff departed, in his original patent, from the principle of the old structures by joining his step-cover to the step and having the vertical plate yielding and flexible, so that its elasticity may keep the door open or closed. This, so far as appears, was a new invention, and he was entitled to claim it. He did claim it, and the original patent was adequate to secure it to him. The first claim of the reissue, if construed so as to cover the defendant's structure, must equally cover the old structures referred to." (46)

WING v. ANTHONY, 106 U. S. 142 [1882]

Interval—5 years

Motive of Reissue—To enlarge disclosure and claim to change invention from a particular plate holder and camera to a broad method of carrying on a process.

Subject Matter—Photographic apparatus or process.

HELD

"It is manifest that the reissued patent was taken out for the purpose of embracing under its monopoly what was not included by the original patent. The original patent was not, in the language of the statute, 'inoperative or invalid by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new.'

The original claim was for a mechanism; namely, 'a plateholder in combination with the frame in which it moves, constructed and operating in the manner and for the purpose' set forth in the specification. The claim of the reissued patent is plainly for a process; namely, 'the bringing of the different portions of a single plate, or several smaller plates, successively into the field of the lens of the camera, substantially in the manner and for the purpose specified'.

This claim would cover any mechanism by which the different parts of the plate could be brought into the field of the lens. In fact, the specification of the reissued patent suggests a different contrivance; namely, the causing of the lens of the camera to be made adjustable in different positions with respect to the plate, while the plate remains stationary, so that different portions of the plate may be brought into the field of the lens.

It is quite clear that the original patent covers a mechanism to accomplish a specific result, and that the reissued patent covers the process by which the result is attained, without regard to the mechanism used to accomplish it. The reissue is, therefore, much broader than the original patent, and covers every mechanism which can be contrived to carry on the process." (145-146)

"His device was simply a new and specific means to take advantage of a well-known law of nature. In his reissue, by claiming as his invention the process of bringing different parts of the plate successively into the field of the lens, he seeks to put himself in as good a position as if he had been the first to discover the law referred to, and the first to invent the method of taking advantage of the law by tilting his camera into different positions. In claiming the process he excludes all other mechanisms contrived to accomplish the same object. This he could not rightfully do." (146-147)

MOFFITT v. ROGERS, 106 U. S. 423 [1882]

Interval—2½ years

Motive of Reissue—To include device not originally shown and palpably not within description.

Subject Matter—The original patent was for an elongated shoe heel shaper mounted eccentrically upon a shaft. The reissue changed an essential respect.

HELD

"The original patent covered an elongated heel-shaped former, set eccentrically upon its shaft. This was an essential part of the invention described in the original patent." (426)

"The specification of the reissued patent omits both of these statements, and thus allows a 'former' to be made, if desired, with a circular cross-section, and to be set concentrically on its shaft. It is, therefore, clear that it covers a contrivance essentially different from that described in the original specification and claim." (427)

"The difference between the device covered by the specification and first claim of the original patent, and the device which might be embraced by the specification and first claim of the reissued patent, is essential and palpable." (427)

"The specification and first claim of the reissued patent are a plain attempt to include a device which was not and could not be fairly covered by the original patent. That claim is, therefore, for that reason void." (428)

HOFFHEINS v. RUSSELL, 107 U. S. 132 [1882]

Interval—4 years

Motive of Reissue—To alter description and enlarge claim.

Subject Matter—The patent dealt with a particular harvesting mechanism including a revolving rake.

HELD

"The original patent, No. 35,315, in stating what the invention is, says that it consists of certain improvements 'in the manner of mounting and operating a revolving rake.' There were three features set forth in the specification of No. 35,315: 1. The peculiar construction of the reel and rake. 2. The peculiar form and location of the rake-post. 3. The peculiar manner of operating the rakes. There were only three claims in No. 35,315, one covering each of said three features, * * *" (135)

"There is no warrant in the original patent for locating the rake-support, or any part of it, on the finger-beam." (138)

"The special kind of support described and shown in the patents, original and reissued, is essential to the operation of the special kind of raking apparatus there described. But the appellees' machine has a raking apparatus differently organized." (139-140)

"In analyzing the two machines, in view of the state of the art, it appears that the appellant adapted a continuously revolving gathering and discharging rake to a two-wheeled loosely jointed finger-bar machine. To do this he employed a peculiar rake and a peculiar rake-support. The appellees employ an entirely different rake. They have a

series of radial arms pivoted each independently of every other in a head, which has a double cam guideway for each arm, and the arms are thereby elevated vertically so as not to strike the frame in passing up. This makes it possible for the appellees to place the support for their rake on the finger-beam by the side of the frame and in the line of the cutters instead of behind the frame. No such organization is possible with the appellant's arrangement of rakes." (140)

"The appellees have not borrowed from the appellant. They devised a new arrangement of rake which made it possible for them to mount their rake-support on the heel of the finger-beam proper, where the appellant can never mount his and where that of the appellees is mounted. The theory of the reissue appears to be that, as the original patent shows a special device for supporting a special arrangement of rakes, such device being located on a particular part of the platform other than, and not possible to be, a part of the finger-beam, he can claim in a reissue any device for supporting a revolving rake, even one located on the finger-beam. To carry out this view, the word 'finger-beam' is interpolated in the specification, in this connection, as an addition to the word 'platform,' and the rake-post is described as being attached to the finger-beam *or* the platform. But there is an entire absence in the original specification, and in the reissued specification, of any description of any means by which the rake-support can be attached to or mounted on the finger-beam, or by which the rakes can be made to work with the rake-support in that location, or by which the connecting-rod of the cutters can be free to work with the support so placed. The law of reissues never at any time, or under any construction, allowed that to be done which has been thus attempted in this case." (141)

"The appellant's belt could not, in the same position, drive the raking apparatus so as to make it work properly. The appellees, by the use of sprocket-pulleys and a chain, dispense with a tight friction-band, and with a pulley around which the platform vibrates, and with a tightening pulley. Their arrangement is not an equivalent, in mechanism or functions, for that of the appellant." (142)

"The appellant's structure shows no such organization, and does not involve what the appellees have done." (143)

GAGE v. HERRING, 107 U. S. 640 [1882]

Interval—14 years

Motive of Reissue—To claim subject-matter materially different.

Subject Matter—The original narrowly claimed a particular new combination of seven old elements. The reissued claimed a sub-combination of three elements.

HELD

"No new device was invented by Denchfield, but his improvement consisted in a new combination of old means and devices. That combination, as described in the specification of his original patent, includes seven elements, * * *" (643)

"But the fan, with its communicating spout and meal chest, the dust room, the two conveyors, and the elevator, tend to one result, the cooling and drying of the meal, without waste or loss 'on its passage from the grinding stones to the bolts,' 'the whole,' as stated at the beginning of the specification, 'forming a simple and economical device;' and the single claim in the original patent is for

the arrangement and combination of the seven elements, designating them all with equal distinctness by appropriate letters.

The reissue was granted more than thirteen years and eight months after the date of the original patent, and less than four months before that patent would have expired; * * *" (644)

"The plaintiffs do not contend that in the original specification the patentee claimed as his own invention more than he had a right to claim as new; or that there is any defect or insufficiency in any part of the description or specification, other than the final claim. The descriptive part is, word for word, the same in the original and in the reissue. It is argued that the claim in the original patent was too much restricted by including in the combination elements which were no part of the real invention, and that this mistake might properly be corrected in the reissue. But there being no error in the descriptive part of the specification, any mistake in the claim, which is the more important part, and upon which other inventors and the public have the right to rely, as defining the limits of the invention patented, would be apparent on the face of the patent and could not escape the notice of any person reading it with the least care and attention." (645)

"To uphold such a claim, made so late, would be to disregard the principles governing reissued patents, stated upon great consideration by this court at the last term in the case of *Miller* v. *Brass Company*, 104 U. S. 350, and since affirmed in many other cases." (645)

DUFF v. STERLING PUMP COMPANY, 107 U. S. 636 [1882]

Interval—4½ years

Motive of Reissue—To claim subject-matter broader than actual novelty.

Subject Matter—The patent was for a wash-board having a rubbing surface of a particular shape. The reissue claim was broadened.

HELD

"The case is one where, in view of the state of the art, the invention must be restricted to the form shown and described by the patentee. In the field of wash-boards made of sheet metal, with the surface broken into protuberances formed of the body of the metal, so as to make a rasping surface, and to strengthen the metal by its form, and to provide channels for the water to run off, Todd was not a pioneer. He merely devised a new form to accomplish these results. *Railway Company v. Sayles*, 97 U. S. 554. The defendant adopts another form. Under such circumstances the Todd patent cannot be extended so as to embrace the defendant's form. The latter is not a mere colorable departure from the form of Todd, but is a substantial departure." (639)

CLEMENTS v. ODORLESS EXCAVATING APPARATUS CO., 109 U. S. 641 [1884]

Interval—5 years

Motive of Reissue—To enlarge claim to dominate interim device.

Subject Matter—The patent was for apparatus for cleaning vaults including a cask with a check valve controlling the inlet at the bottom and a flow valve con-

trolling the outlet at the top. The defendant's apparatus had no check valve and no substitute or equivalent.

HELD

"There is not in the specification of the original patent any suggestion or indication of any invention other than the two combinations severally claimed in the two claims. In the reissue there are material enlargements of the scope of the invention described and claimed in the original patent, and, apparently, with a studied view to include and cover, by descriptive words and by broader claims, an apparatus like that used by the defendant." (647)

"The original specification indicates nothing but a cask having the entrance opening in its bottom, furnished with a check-valve to open and shut such entrance automatically, the cask suspended vertically over the vault and lowered into it until the funnel at the bottom is sufficiently immersed, the filling of the cask in that position, and the raising it and emptying it. The cask in the defendant's apparatus has the entrance opening in its top, has no check-valve, is not suspended over or lowered into the vault, is placed at a distance from the vault, and is connected with the vault by a flexible pipe." (648)

"The effort was to obtain a reissue which should cover an apparatus having the cask located at a distance from the vault, with a flexible pipe from it to the vault, and a receiving opening in the top of the cask, and no check-valve—all of them features not indicated in the original patent, but all of them features existing in the Scharf patent granted after the original Bull patent and before the application for its reissue. The same observations apply to the patent to Frazier, No. 168,473, granted October 5th, 1875, more than three months before reissue No. 6,962 was applied for." (649)

"The expansions in claims 1 and 3 of the reissue were afterthoughts, developed by the subsequent course of improvement in the Schaff and Frazier patents, and intended to cover matters appearing in those patents and not claimed in the original patent, No. 115,565. No excuse is given for the delay in applying for the reissue, nor is any actual inadvertence, accident, or mistake shown." (649-650)

McMURRAY v. MALLORY, 111 U. S. 97 [1884]

Interval—9 years

Motive of Reissue—To broaden to cover interim device.

Subject Matter—The original was for a particular construction of soldering iron for can tops. The reissue did not alter the disclosure but enlarged the claims to cover an interim different construction. The difference between the original and reissue dealt with an essential element.

HELD

"The claim of the original patent was for a combination; that is to say, a combination of the disk A with the recess B on its under side, and the movable rod D to hold the lid of the can while resealing or closing. The specification mentioned a disk and particularly described and illustrated it as forming a part of the combination. By its size, shape, and the recess in its under surface, it was designed to perform certain specified functions. It was made thick so as to retain the heat; it was made circular, like the lid of the can, and of sufficient diameter to cover the lid, so as to reach its outer edge, where the soldering was to be done, and it had the recess in its under side sufficient to give room for the convexity of the lid so as to confine the soldering process to the outer edge of the lid.

The patent did not therefore include every soldering-iron of whatever form and shape." (102-103)

"In the reissue the first three claims of the Barker patent are expanded so as to include all soldering-irons, no matter what their shape or size, or specific advantages, in combination with the movable rod D. The contention of the appellants that a device so unlike the soldering-tool described in the original Barker patent as the Tillery & Ewalt tool is embraced by the first three claims of the reissue, is striking proof of the expansion of the original claim. It is plain that the claims mentioned include many soldering devices not covered by the original patent. The claims are therefore void." (103)

COCHRANE v. BADISCHE ANILIN & SODA FABRIK,
111 U. S. 293 [1884]

Interval—1½ years.

Motive of Reissue—To claim product dye however made, instead of one particular process.

Subject Matter—The original claimed a two-step process for making a chemical product alizarine. The reissue claimed the product, however made. The Court considered the prior art at length to evaluate the invention.

HELD

"It does not satisfactorily appear that the process of No. 4,321 will produce the defendants' article to any useful extent, if at all. The process of No. 4,321 never was, and is not now, practically carried on anywhere." (306)

"It is very plain that the specification of the original patent, No. 95,465, states the invention to be a process for preparing alizarine, not as a new substance prepared for

the first time, but as the substance already known as alizarine, to be prepared, however, by the new process, which process is to be the subject of the patent, and is the process of preparing the known product alizarine, from anthracine." (308-309)

"There is another view of the case. According to the description in No. 95,465, and in No. 4,321, and the evidence, the article produced by the process described was the alizarine of madder, having the chemical formula $C_{14}H_8O_4$. It was an old article. While a new process for producing it was patentable, the product itself could not be patented, even though it was a product made artificially for the first time, in contradistinction to being eliminated from the madder root. Calling it artificial alizarine did not make it a new composition of matter, and patentable as such, by reason of its having been prepared artificially for the first time from anthracine, if it was set forth as alizarine, a well known substance. *The Wood Paper Patent*, 23 How. 566, 593. There was, therefore, no foundation for reissue No. 4,321, for the product, because, on the description given, no patent for the product could have been taken out originally.

Still further, the claim of No. 4,321 is not a claim merely for the product of the process described in it, but is a claim for anything which may be called artificial alizarine, produced from anthracine or its derivatives, by either of the methods described, or by any other method, equivalent or not, which will produce anything called artificial alizarine. The scope of such a claim is seen in this suit. An article is sought to be covered by the reissue, which it is demonstrated Graebe and Liebermann never made by their bromine process, which they knew that process would not produce, which they recognized as produced first by some one else by a different process, and which has become the subject of a large industry abroad and an extensive use in this country, through discoveries made, as they

acknowledge, since their bromine process was invented. After those discoveries were made, after it was seen that the bisulpho-acid process would produce desirable dye-stuffs, and could be worked practically and profitably to that end, it was sought to control the market for the product in the United States, by obtaining this reissue No. 4,321." (311-312)

TURNER & SEYMOUR MFG. CO. v. DOVER STAMPING COMPANY, 111 U. S. 319 [1884]

Interval—12 years

Motive of Reissue—To enlarge specification and claims for dominating interim devices.

Subject Matter—The patents dealt with a familiar form of egg beaters. The original was limited to a specific series of illustrated cutting edges. The reissue covered every rotating beater frame formed of thin blades.

HELD

"We are quite satisfied that the difference between the original claim and the first claim of the reissued patent, is substantial and not verbal. The former is necessarily limited to the particular device described as a frame, with a series of cutting edges attached, in the mode designated, and capable of rotation. The latter embraces every revolving beater-frame, formed of thin, plain blades or cutters, arranged to cut edgewise through the material by their rotation. It is immaterial whether or not the latter might have been covered by the language of the specification, as included in the invention. We are dealing with the claims, and nothing else. And it cannot be successfully contended that the original claim implicitly contained all that is expressed in the claim of the reissued patent. The original claim has been made broader by the reissue, so as

to embrace the device used by the appellants, which was not previously an infringement.

And that raises the question, whether, under the circumstances disclosed by this record, the reissue is valid.

To avoid this question, it is, indeed, contended now by the appellees, that the two claims under examination are identical; that their apparent differences are merely literal; that their meaning is the same; and this conclusion is thought to be reached, not by restraining the reissue to the language of the original, but by a process of construction, by the use of supposed implications, to expand the words of the original so as to cover everything embraced in the reissue; the only alternative, indeed, that could be adopted, to escape the inconsistency of maintaining that claims, which were diverse upon the question of infringement, were identical upon the question of the validity of the patent.

But, as already intimated, this position is not tenable. There is nothing in the language or recitals of the original patent, nor are there any just and reasonable inferences of which they are susceptible, which justify a construction of the claim that would embrace any device other than that described in the specifications and represented in drawings; much less to include every mechanical arrangement which embodies a cutting edge with a revolving frame, to cut instead of break the egg material upon which it is meant to operate.

The question then recurs, what are the circumstances which affect the validity of the reissue, and how do they affect it?

They are few, but decisive. The original patent was issued July 7th, 1863. Eleven years after, in 1874, the competition of the appellants' device became apparent and was felt. In 1875, application was made for the reissue; the original patent was surrendered and the reissued patent granted, July 13th, 1875. Here is a delay of nearly twelve years, without the offer of an explanation or excuse, with-

out even the suggestion of inadvertence or mistake in the original application. The only inference that can be drawn is, that the discovery and experience of successful competition in 1874 suggested first and led to the discovery, that the original claim did not cover everything that might have been embraced, and was not broad enough to maintain the monopoly desired but not secured.

This brings the case directly within the principle of *Miller* v. *Brass Company*, 104 U. S. 350, and the numerous others which have followed it, including that of *Clements* v. *Odorless Apparatus Company*. 109 U. S. 641, all of which have been decided since the interlocutory decree in this case was pronounced." (325-327)

MAHN v. HARWOOD, 112 U. S. 354 [1884]

Interval—4 years

Motive of Reissue—To broaden claim after too long delay.

Subject Matter—The invention was in a leather cover for baseballs. The original claimed a combination of inner and outer covers with seams at right angles and also a special double herring-bone stitch in combination with two covers arranged to have break-joint seams. The reissue was broadened and claimed a cover of two parts secured by a single seam and also the herring-bone stitch alone. The description was not substantially altered and the object of the reissue was to broaden the claim. The subject matter was simple and readily understandable and the Court in this case laid down the rule that delay of more than two years prevented reissuance merely for broadening claims.

HELD

"The whole invention claimed, therefore, in the original patent, was, first, the two leather covers (an outside one

and and inside one), with their respective seams crossing at right angles; and second, the double herring-bone stitch in combination with the two covers." (356).

"It is apparent that, in the reissue, the claim of invention is greatly enlarged. The patentee claims therein, first, any and every single base-ball cover formed of two pieces of leather, fastened together by a single seam, substantially as and for the purpose described; secondly, any and every base-ball cover having its seam united by the double herring-bone stitch, substantially, &c.; thirdly, every and any use of two covers on a base-ball, each made of two pieces of leather, and applied to the ball independently of each other, substantially, &c. The fourth claim is nearly equivalent to the first claim of the original patent. The others are all new.

It is clear, therefore, on the face of the patents, that the only object of the reissue was to enlarge the claims. The description was not altered in the least. The claims in the original patent were clear and explicit, one of them being substantially retained in the reissue. Nothing was altered, nothing was changed, but to multiply the claims and to make them broader." (357)

"Conceding that it is for the Commissioner of Patents to determine whether the insertion of too narrow a claim arose from inadvertence, accident or mistake (unless where the matter is manifest from the record), the question whether the application for correction and reissue is or is not made within reasonable time is, in most if not all of such cases, a question which the court can determine as a question of law, by comparing the patent itself with the original patent, and, if necessary, with the record of its inception. The reason for this was fully explained in the case of *Miller* v. *The Brass Company*." (360)

"The public has the undoubted right to use, and it is to be presumed does use, what is not specifically claimed in the patent. Every day that passes after the issue of the patent adds to the strength of this right, and increases the barrier against subsequent expansion of the claim by reissue under a pretense of inadvertence and mistake. If any such inadvertence or mistake has really occurred, it is generally easily discernible by an inspection of the patent itself; and any unreasonable delay in applying to have it corrected by a surrender and reissue is a just bar to such correction. If the specification is complicated and the claim is ambiguous or involved, the patentee may be entitled to greater indulgence; and of this the court can rightfully judge in each case. No precise limit of time can be fixed and laid down for all cases. The courts will always exercise a proper liberality in favor of the patentee. But in any case, by such delay as the court may deem unnecessary and unreasonable, the right to a reissue will be regarded as having been abandoned and lost, and the Commissioner will be held to have exceeded his authority in granting it. Whenever it is manifest from the patent itself, compared with the original patent and cognate documents of record, or from the facts developed in the case, that the Commissioner must have disregarded the rules of law by which his authority to grant a reissue in such cases is governed, the patent will be considered as void to the extent of such illegality. It is then a question of law, not a question of fact." (361-362)

"The specification is very plain and free from complexity, and as we have already stated, the claims in the original patent were clear and explicit. There was no ambiguity, and nothing to prevent the patentee from seeing at once, on inspecting his patent, whether his whole invention was claimed or not. We can see no possible excuse, and none has been attempted to be shown, for

allowing the patent to stand the length of time it did without any attempt to have it amended. The reissue was made against law apparent on its face, and nothing is shown in the record to remove this illegality. The case is clearly within the principle laid down in *Miller* v. *The Brass Company*, and the patent must be regarded as void so far as the new and expanded claims are concerned." (363)

TORRENT ARMS LUMBER COMPANY v. RODGERS, 112 U. S. 659 [1884]

Interval—5 years

Motive of Reissue—To alter disclosure and enlarge claim to dominate interim machine.

Subject Matter—The patent was for a machine for turning logs on the carriage of a saw-mill.

HELD

"In the reissue the specification is modified so as to make a radical change, not only in the purpose, but in the mechanism of the invention. In the original patent the invention was declared to be an improved device for turning or rolling logs upon the carriage of a saw-mill. In the reissue the invention was declared to be a device for turning or rolling logs *to or* upon the carriage. The device, as described in the reissued patent, is adapted, not only to turn logs on their axes, but to roll them from one place to another, as from one part of the log-deck to another, or from the log-deck to and upon the carriage. This requires a change of mechanism. To turn a log when on the carriage without change of its location requires that the toothed-bar should be placed as closely as possible to the side, or within the side of, the carriage, and there must be knees to prevent a change in the location of the log.

To roll a log to the carriage, or to roll a log from the log-deck upon the carriage, the toothed-bar must be at a distance from the carriage at least as great as the diameter of the log, and the slot in which it works must be extended accordingly, and the knees are not only unnecessary, but would be an obstruction to the operation of the device." (667)

"The change of the specification, therefore, includes an omission of the knees, a change in the location of the toothed-bar, a change in its movements, and a change in the effect produced by its movements. The reissue, consequently, covers a different invention from that described in the original patent. It embraces a different machine, intended for different purposes and performing different functions, from that described in the original patent." (667-668)

"We find, therefore, that the specification and first claim of the reissue was an enlargement of the claims of the original patent, and covered an invention not covered or described therein; that the reissue was not applied for until nearly five years after the date of the original patent, and not until another inventor had made a substantial advance in the art to which the original patent belonged, which the assignee of the original invention, it may be fairly inferred, desired to include in the monopoly of his patent, and that he sought to accomplish this by its reissue. The first claim of the reissued patent was therefore void." (669)

Coon v. Wilson, 113 U. S. 268 [1885]

Interval—3 months

Motive of Reissue—To change description and enlarge claim to dominate interim marketed product.

Subject Matter—The original patent was for a collar having two short bands stitched along the bottom and with their ends projecting beyond the front and provided with button holes. The reissue was changed to cover a continuous band.

HELD

"The defendants' collars have bands which are continuous from end to end of the collar, and are not in two parts, nor divided by any vertical or other seam, at the centre of their length or elsewhere. They have no short or sectional bands, which start from the centre of the collar, or from any point between the centre and the ends. The band is not shorter than the length of the collar. In the original patent, the invention is stated to be a collar having short or sectional bands, that is, the collar has not a continuous band, of one piece of cloth as long as the collar, and extending from end to end of the collar, but has its band made in two sections, and each of those sections starts or begins to run from the centre of the length of the collar, or from a point between the centre and the end, to and beyond the end. The bands have a graduated curve and increasing width, from their starting points, to and beyond the ends of the collar. But that is only one feature in the claim of the original patent. The other feature, the sectional bands, is made equally important in that claim, and a collar is not the collar of that claim unless it has both of those features. That claim is limited to a collar with those features, 'substantially as described and shown.'" (275)

"The defendants' collars were first made and sold after the original patent of Wilson was granted, and after the defendants had seen sectional band collars made under it. The first of the defendants' four collars was made and sold in February 1878, and the other three in March, or

April, or May, 1878. The reissue was applied for March 11, 1878 and Wilson testifies that his impression is, that he had previously heard of the defendants' collars. It is evident that the reissue was obtained because of defendants' collar, with a continuous band, had been put on the market, and for the purpose of obtaining claims which would certainly cover such a collar. The changes made in the specification and claims show this. The specification of the reissue, in stating what the invention consists of, omits the statement that it is a collar having *sectional* bands, and states that it is a collar having *curved and graduated* bands. It also omits the statement that bands *start* from the centre, or from a point between the centre and the ends, and states that the curved and graduated bands *extend along the lower edge of the collar*, from the centre, or from a point between the centre and the ends." (276)

"Although this reissue was applied for a little over three months after the original patent was granted, the case is one where it is sought merely to enlarge the claim of the original patent, by repeating that claim and adding others; where no mistake or inadvertence is shown, so far as the short or sectional bands are concerned; where the patentee waited until the defendants produced their continuous band collar, and then applied for such enlarged claims as to embrace the defendants' collar, which was not covered by the claim of the original patent; and where it is apparent, from a comparison of the two patents, that the reissue was made to enlarge the scope of the original. As the rule is expressed in the recent case of *Mahn* v. *Harwood*, 112 U. S. 354, a patent 'cannot be lawfully reissued for the mere purpose of enlarging the claim, unless there has been a clear mistake, inadvertently committed, in the wording of the claim, and the application for a reissue is made within a reasonably short period after the original patent was granted.' But a clear mistake, inadvertently committed

in the wording of the claim, is necessary, without reference to the length of time. In the present case, there was no mistake in the wording of the claim of the original patent. The description warranted no other claim. It did not warrant any claim covering bands not short or sectional. The description had to be changed in the reissue, to warrant the new claims in the reissue." (277)

EACHUS v. BROOMALL, 115 U. S. 429 [1885]

Interval—1½ years

Motive of Reissue—To claim broader subject matter than novelty permitted.

Subject Matter—The original narrowly claimed a combination of structural elements in a machine for cutting paper. The reissue claimed the process of sawing paper-board in the wet state as taken from the paper making machine.

HELD

"A comparison of the two patents, for the purpose of determining the question raised as to the identity of the inventions described in them, requires an interpretation of the original patent in the light of the state of the art at the date when the application for it was filed." (434)

"It is manifest, from this state of the art, that it was not open to the appellant, at the time he applied for his patent, to claim as his invention the discovery that heavy paper, intended for the use of bookbinders and box-makers, could best be cut into proper shapes and sizes, while in wet sheets, as they came from the machine, nor that the cutting could best be performed by cutters with serrated edges. For this was matter of general knowledge and common practice." (435)

"It is plain, then, that the only invention exhibited in the drawings, or described in the specifications of the original patent, consists in the particular organization of the machine described, whereby the various parts are combined and adjusted, so as to fit it to accomplish the specific result of cutting heavy paper when in large sheets and in a wet condition, as received from the paper-making machine, into smaller sizes and other shapes, for use as boards in bookbinding and box-making." (436)

"We turn now, for the purpose of comparison, to the reissued patent. In the specification thereto the patentee declares that he has invented, not a machine, but 'a new and improved process of cutting paper boards,' of which a description follows; that the drawings referred to are views of 'my machine for conducting my process;' that the invention consists 'in subjecting paper, while in a wet state, as it is taken from the paper-making machine, to the action of circular cutters having serrated edges, whereby the sheets are cut evenly and economically, and the trimmings can be returned to the paper machine without regrinding or other treatment * * * .'" (436)

"A comparison of the two patents makes it very clear, that, if the patentee had in fact conceived the idea of enlarging the scope of his invention by development from a machine into a process, he has taken no pains to conceal or disguise his purpose. For he entitled his original patent as for a new and useful machine for cutting paper boards, while with equal explicitness, in his reissue, he declared that he had invented a new and improved process of cutting paper boards." (437-438)

"The patent is plainly limited by its language to the combination, arrangement and adjustment of the particular parts of the very machine described, for the uses to which

it is declared to be applicable. On the other hand, the claim of the reissue patent is broad enough to cover the process of sawing paper boards in a wet state by means of a hand-saw; and if, for the purpose of saving it from the necessary consequences of such a claim, it is restrained by construction so as to include only the process described when performed by means of circular cutters having serrated edges—terms of limitation to be found in the specification—it is still broad enough to cover every arrangement, combination and adjustment in which these elements may be found; and this surely is not the same invention as that described in the original patent." (438-439)

BROWN v. DAVIS, 116 U. S. 237 [1886]

Interval—11 years

Motive of Reissue—To enlarge description and claim to dominate interim marketed machine.

Subject Matter—The patents were for grain drills. The original had three claims to particular combinations of elements in the machine. The reissue added additional claims to broader sub-combinations of elements.

HELD

"In order to determine what construction ought to be given to the other claims of the reissue, it is necessary to consider an invention made by one Powers, at Madison, Wisconsin, in 1862, the invention of Davis being carried back only to September, 1866." (250)

"In view of this invention of Powers, we are of opinion that the invention of the Davis patent must be limited, so far as the shifting apparatus is concerned, to the special arrangement of the rotating crank-shaft described, and

shown in the drawings. The words 'substantially as described,' found in each of the first two claims of the original patent, properly confined those claims to the shifting mechanism described. If claim 1 of the reissue is given a construction which includes any arrangement for shifting not substantially using a rotating crank-shaft, it becomes a claim which could not lawfully have been granted in the original patent; and, as a claim in a reissued patent, it is invalid, within the defences set up in the answer, because the application for the reissue was made nearly eleven years after the original patent was granted, and after machines effecting the shifting by other means than a rotating crank-shaft had gone into use subsequently to the date of the original patent, and no sufficient excuse is given for the laches and delay. The same remarks apply to claim 3 of the reissue.

In view of the rulings of this court on the subject of reissued patents, made since the decision in this case was made by the court below, in May, 1881, this case must be considered in view of the fact that the new matter introduced into the specification of the reissue was put in for the purpose of reaching machines which the claims of the original patent would not reach, and of laying a foundation for claims 1 and 3 of the reissue." (251)

GARDNER v. HERZ, 118 U. S. 180 [1886]

Interval—7 years, 5 months

Motive of Reissue—To claim substantially different subject matter.

Subject Matter—An original patent issued in May 1872. It was first reissued in July 1876 and a second reissue (in suit) was granted, February 1880. The patents dealt with laminated veneer chair seats.

HELD

"While the first reissue was in life the owners of it brought a suit in equity against the present defendants, in the same court, alleging infringement of the first five claims of the first reissue." (187)

"The conclusion of the court was, that there was nothing new or patentable in the first five claims of Gardner's first reissue, in view of the patents referred to. It was not claimed that the sixth claim of that reissue had been infringed." (188)

"A little over five months after this decision was made, the second reissue was applied for, and about four months after it was granted this suit was brought." (188)

"• • • the Circuit Court held, in this case, that the only question open, as to the second reissue, was, whether the concavity of form, made an element of the second claim of that reissue, would support the patent. Concurring, as we do, in the views and conclusions of the court, and finding them well expressed in its opinion, we repeat them here: • • •

'If there was no patentable novelty in using the perforations of the metal or gutta-percha chair-seats in the veneer seat by Gardner, neither can there seem to be any in employing a well-known form of chair seat in his veneer seat.' • • •

'In conclusion, in view of the former decision of this court, the complainant can only succeed upon the theory that, by imparting a concave form to his chair-seat, he has imparted sufficient patentable novelty to his article to sustain a patent; and this when such a form of chair-seat was old, the material used was old,

and the method of imparting the form to the material was old. This theory cannot stand.'" (189-190)

"The fabric being old, the suggestion to construct chair-seats out of it being old, the shaping of it in a former being old, the perforation of a seat for ventilation and ornamentation being old, and the giving of a concave shape to a wooden seat by pressure being old, there cannot, in view of the disclaimers in the second reissue, be anything patentable in the structure. It was convenient to sell and convenient to buy, and commercially a good article. But a patent cannot be taken out for an article, old in purpose and shape and mode of use, when made for the first time out of an existing material, and with accompaniments before applied to such an article, merely because the idea has occurred that it would be a good thing to make the article out of that particular old material. Beyond that, the suggestion in the second reissue, that 'the seat is adapted to be secured to any chair-frame, as it is easily cut and fitted to the same,' is not found in the original patent, or in the first reissue; and is new matter, so far as anything in it can be invoked to confer patentability on the article." (192)

WHITE v. DUNBAR, 119 U. S. 47 [1886]

Interval—5 years

Motive of Reissue—To enlarge specification and claims to dominate interim article.

Subject Matter—The original patent was for an improved method of canning shellfish, which included placing a textile fabric between the metal can and the contents. The reissue claimed interposing a protective material between the can and the contents. The reissue was held barred as violating the two year rule against patent reissues.

HELD

"We are clearly of opinion, therefore, that the original patent is not susceptible of the broad construction which the appellees would give to it; and that the reissued patent is a material expansion and enlargement of it. As such expansion appears to be the only object of the reissue, and as the application for the reissue was not made until nearly five years after the original was granted, the case comes within the ruling of *Miller* v. *Brass Company*, 104 U. S. 350, and subsequent cases to the same purport." (52)

NEWTON v. FURST AND BRADLEY COMPANY,
119 U. S. 373 [1886]

Interval—13 years

Motive of Reissue—To change the disclosure and broaden claims to dominate interim marketed machines.

Subject Matter—The patents dealt with gang plows. The original narrowly claimed the combinations of particular elements. The reissue claimed broader subcombinations. The prior art showed the invention narrow.

HELD

"The Circuit Court was of opinion, that, if the state of the art was such as to entitle Davenport to a broad claim for any device by which the plough is lifted by the power of the team through a brake or friction-clutch, the defendants' machine would infringe. But the court found that, prior to Davenport, devices had been used in agricultural implements for utilizing by means of a brake the motion of the carrying-wheel, through a crank-axle, in raising operative parts of the machine from the ground, which devices were so alike in structure and so analogous in use to those of Davenport, as to require his claims to be lim-

ited to his specific devices. In view of those prior devices the Court held that the defendants' friction-band could not be regarded as the same means for engaging and disengaging the carrying-wheel and the axle as the brake of Davenport; and that the defendants' crank-axle was not the plaintiff's hinged board. In these views we concur.

The reissue was applied for more than thirteen years after the original was granted, and after the defendants had begun to make machines of the pattern now complained of. The original patent did not make a swing-axle and a carrying-wheel elements in the combination of the first claim of that patent. The reissue was evidently taken to cover the defendants' machine, which did not infringe the first claim of the original patent, because it did not have the Davenport brake R. No mistake or inadvertence is shown." (384-385)

IVES v. SARGENT, 119 U. S. 652 [1887]

Interval—3½ years

Motive of Reissue—To dominate interim device

Subject Matter—The patents dealt with door bolts. The original claimed certain combinations of particular elements and the reissue added a claim to a different combination and a claim to a single element.

HELD

"The whole question is, whether the patentee and his assignee are entitled, under the circumstances of the case, to claim the pitman E, operating as a pitman and spring in a door-bolt, as a distinct and separate invention, irrespective of its combination with the exterior and interior cases mentioned in the first and second claims." (658)

"On this application the patent was issued, and it does not appear to have been read or examined by any of the parties in interest until after the appellee commenced making the bolts now alleged to be an infringement. It was then discovered for the first time that the original patent did not cover the claim as now made, and the reissue was obtained to effect that purpose." (660)

"In the present case no special circumstances in excuse for the delay are alleged. The excuse proffered is simply an attempt to shift the responsibility of the mistake, as originally made, from the patentee to his solicitor; but no excuse is offered why the patentee did not discover the negligence and error of his solicitor in due time. On the contrary, he assumed, without examination, that the specification and claims of his patent were just what he had desired and intended they should be, and rested quietly in ignorance of the error and of his rights for nearly three years, and then did not discover them until after others had discovered that he had lost the right to repair his error by his neglect to assert it within a reasonable time.

We are, therefore, of opinion that the Circuit Court was clearly in the right in deciding the reissue void as to the third and fourth claims, on the ground that the right to apply for it had been lost by the laches of the patentee and his assignee." (662)

"We are also of opinion, however, that the reissue is void on the other ground, viz., that it contains new matter introduced into the specification, and that it is not for the same invention as that described in the original patent." (p. 662)

"There is nothing whatever in the drawings to show that the patentee claimed to be the inventor of that part separate from the combination, as a distinct novelty, useful by

itself, or in any other combination; neither is it so described in the specification." (662-663)

"We are, therefore, constrained to the conclusion that the addition of the third and fourth claims, with the corresponding alterations in the specification, is such an expansion of the invention as originally described as to destroy its identity, and to that extent to avoid the reissued patent." (663)

HARTSHORN v. SAGINAW BARREL COMPANY,
119 U. S. 664 [1887]

Interval—9 years

Motive of Reissue—To enlarge disclosure and to copy broader claim obtained by another nine years before.

Subject Matter—Structure of Window Shade Rollers.

Fact Summary: Independent inventors Hartshorn and Campbell employed the same solicitor to obtain their patent. The solicitor assumed that Hartshorn had priority and obtained a broad claim in the Hartshorn patent and a narrow claim in the Campbell patent. Nine years later correction was sought by reissue to put the broad claim in the Campbell patent.

HELD

"Campbell's acquiescence in Hartshorn's claim must be regarded, so far as he is concerned, as an abandonment of any right on his part to a patent for the same invention, and, having deliberately rested in that acquiescence for a period of between nine and ten years, it is too late, according to the settled source of decisions in this court, to resume his rights. * * *

Campbell contented himself with the narrow claim originally contained in his patent of 1867, and thereby acknowledged that he was not entitled to the broader claim which he now asserts under his reissue. He had the means and the opportunity at the time the application for his original patent was pending to have asserted his claim to priority of invention; he chose not to do so. He acquiesced in the claim of his adversary; he cannot now claim what he then abandoned." (674-5)

" * * * the reissue of the Campbell patent was not for the same invention described and claimed in the original. This does not rest merely on the enlargement and change in the nature of the claim. The specification itself was substantially altered. The alterations, it is said in argument, had the effect only of giving a more full, complete, and accurate description of the same mechanism; but, in point of fact, the alterations changed the shape of the specification in such a way as to admit the new and enlarged claim in a manner in which it could not have been made upon the original description. A comparison between the original and reissued patents shows that the specification of the latter has been materially changed so as to cover, as the invention of the patentee, that function of the structure by which the spring will be locked when the roller as a whole is removed from the brackets, in respect to which the original patent is entirely silent." (675)

"In order to understand and resolve the questions arising in the case it will be necessary to consider the state of the art at the time of the issue of the patents." (665)

WORDEN v. SEARLS, 121 U. S. 14 [1887]

Interval—6 years

Motive of Reissue—To enlarge claims to cover interim device.

Subject Matter—The original showed and claimed a whip-socket comprising a holder and pivoted lever to hold the whip steady. The reissue broadened the claim to cover the pivoted lever alone and also in combination with any stationary part of a socket.

HELD

"The specification of the original Scott patent stated the invention to be 'a new and improved fastening applied to a whip-socket'. The socket is described as a complete whip-socket, complete in itself without the fastening, and having in its side an opening or slot, extending nearly its whole height or length, in which slot is inserted a lever. The claim is for 'a whip-socket,' that is, a complete whip-socket, 'provided with a fastening composed of a lever, arranged or applied substantially as shown and described,' that is, inserted in the slot in the socket. The defendants' structure consists only of two sectional halves, each like the other, and each a cone-shaped half-cylinder, and bilged, with an ear-shaped hinge on each half-section, a rivet connecting the two forming the hinge. This arrangement does not infringe the claim of the Scott original patent. It is not a complete whip-socket provided with a lever arranged or applied substantially as in Scott's apparatus, that is, pivoted in a slot in the socket. It is true that the result in each arrangement is to hold the whip steady or firm in a socket, but the mechanisms are different.

That the specification and claims of the reissue were designedly so worded as to cover a structure which the claim of the original patent would not cover is manifest.

Thus, the original specification says that the invention relates to a 'fastening applied to a whip-socket in such a manner as to hold the whip firmly therein.' This means that you have a complete whip-socket and you apply a fastening to it, which fastening is so arranged as to hold the whip firmly in the socket in which the whip is placed. The description in the original specification describes a complete whip-socket, with an opening or slot in the side of the socket, extending nearly its whole height or length, with a fastening lever secured in the slot by a fulcrum-pin rather below the centre of the lever, the lever having near the fulcrum-pin a weighting projection, b'. The reissued specification says that the 'improvements consist in the use of a lever with the stationary or upright portion of the socket'. The socket is referred to as if it had a part which is not stationary. The first and second claims carry out the same idea, by making the 'stationary part' of the socket an element in each of those claims. The defendants' holder is not a complete holder with its stationary part alone, and without its movable part, while the plaintiff's is. Moreover, all mention of the weighting projection b' is omitted in the reissued specification. The design manifest in it is to cover such a structure as that of the defendants, and the evidence tends to the conclusion that that was the object of obtaining the reissue. The description and claim of the original specification were entirely adequate to cover the Scott device. No inadvertence, accident or mistake is shown.'' (23-24)

EAMES v. ANDREWS, 122 U. S. 40 [1887]

Interval—3 years

Motive of Reissue—To modify description and broaden claim to effectuate invention.

Subject Matter—This case dealt with the driven well patent. The original and reissued claims read:

Original	Reissue
The herein described process of sinking wells where no rock is to be penetrated, viz.: by driving or forcing down a rod to and into the water under ground, and withdrawing it and inserting a tube in its place to draw the water through, substantially as herein described. (47)	The process of constructing wells by driving or forcing an instrument into the ground until it is projected into the water without removing the earth upward, as it is in boring, substantially as herein described. (47)

HELD

"The particulars relied on to establish the proposition that the reissued patent describes a different invention from that contained in the original are as follows: 1st. It is said that it is essential to the success of the process that the end of the tube should form an air-tight connection with the surrounding earth; that the tube itself should be air-tight, and attached to a pump with an air-tight connection; which elements are set out in the reissued patent, and are not contained in the original." (56)

"To this view there are two sufficient answers.

1st. We think it is a reasonable inference, from the language employed in the specification of the original patent, that the tube, in the act of being driven into the earth, to and into a water-bearing stratum, would form an air-tight connection with the surrounding earth, and that the pump should be attached by an air-tight connection. This inference reasonably follows from the fact, shown in the evi-

dence, that the mere act of driving the tube, as distinguished from boring, usually results in making an air-tight connection with the surrounding earth." (57)

"2d. But even if this were not so, the case would be simply that of a specification defective for not containing a full and perfect description of the process intended to be patented. It presents the very case of the right secured to a patentee by §53 of the act of July 8, 1870, which provides, 'that whenever any patent is inoperative or invalid by reason of a defective or insufficient specification, . . . if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee,' &c.

If the amended specification does not enlarge the scope of the patent by extending the claim so as to cover more than was embraced in the original, and thus cause the patent to include an invention not within the original, the rights of the public are not thereby narrowed, and the case is within the remedy intended by the statute." (59)

"There is nothing in these additions and amendments which either was not virtually contained by reasonable implication in the original description, or, if new, amounted to more than specific and exact directions to supplement those contained in the original. The invention is not differently described, and is not described so as to be a different invention, nor is the claim enlarged." (60)

"The object and purpose of the amendments to the specification obviously were to meet a possible construction of the original, whereby the patentee would be precluded from the use of his process where it was evidently intended to

be applied, simply because one or more strata of rock had to be penetrated in the process of driving. Such, in our opinion, is not the meaning of the original patent." (62)

"In our opinion, therefore, the grounds on which it is sought to invalidate the reissued patent, as being for a different invention from that described in the original, cannot be sustained.

This conclusion is not in conflict with anything said in *Russell* v. *Dodge*, 93 U. S. 460, 463." (62-63)

PARKER AND WHIPPLE COMPANY v.
YALE CLOCK COMPANY, 123 U. S. 87 [1887]

Interval—1 year and 8 months

Motive of Reissue—To add claim to a different combination of elements to dominate interim marketed device.

Subject Matter—The patents dealt with clock movements. The original narrowly claimed combinations of particular elements. The reissue added claims to combinations of entirely different elements.

HELD

"'If the premise was true, they deny the conclusion, because it is a fact, the truth of which is apparent, that, in the original specification and drawings, the patentee gave no hint that he regarded the construction described in any one of the first eight claims of the reissue as forming any material or immaterial part of his invention.'

On these premises, the court said that 'the eight claims which are in controversy are a total abandonment of the principles which are stated in the original patent to be those of the invention, and are an introduction into the reissue of a subject-matter which has no relation to the original patent, except that each patent relates to clocks.'" (92)

"In these extracts from the opinion it is seen that the court adheres strictly to the view that, under the statute, the Commissioner has no jurisdiction to grant a reissued patent for an invention substantially different from that embodied in the original patent, and that a reissue granted not in accordance with that rule is void. In what is there said about redescribing the invention, and about including in the new description and new claims what was suggested or indicated in the original specification, drawings or patent office model, it is clearly to be understood, from the entire language, that the things so to be included are only the things which properly belonged to the invention as embodied in the original patent; that what that invention was is to be ascertained by consulting the original patent; and that, while the new description may properly contain things which are indicated in the original specification, drawings or patent office model, (though not sufficiently described in the original specification), it does not follow that what was indicated in the original specification, drawings or patent office model is to be considered as a part of the invention, unless the court can see, from a comparison of the two patents, that the original patent embodied, as the invention intended to be secured by it, what the claims of the reissue are intended to cover.

In what was thus said in *Seymour* v. *Osborne*, there is no warrant for the view, that, *ex vi termini*, what was suggested or indicated in the original specification, drawing or patent office model is to be considered as a part of the invention intended to have been covered by the original patent, unless the court can see, from a comparison of the two patents, that the invention which the original patent was intended to cover fairly embraced the things thus suggested or indicated in the original specification, drawings or patent office model, and unless the original specification indicated that those things were embraced in the invention intended to have been secured by the original patent." (98-99)

"If by 'new matter,' in §4916 of the Revised Statutes, is meant such new substantive matter as might be the subject of another application for a patent, there was new substantive matter introduced into the specification of the reissue in the present case; for the description set forth in that specification as the foundation for the first eight claims in it, and those eight claims themselves, might have been the subject of another application for a patent, at the time the original patent was applied for and taken out, leaving that patent valid and operative in respect to the claims it covered.

In the present case, the infringing clock was made by the defendant Lane more than six months before the reissue in suit was applied for. As stated by the Circuit Court in its opinion in this case, the Lane clock did not contain a single patented feature of the Hotchkiss clock, and it was immediately patented and put upon the market. This, therefore, is a case of the amendment of a patent so as to cover improvements not covered by the patent, and which came into use by others than the patentee and his licensee, free from the protection of the patent." (102)

MATTHEWS v. IRONCLAD MANUFACTURING COMPANY, 124 U. S. 347 [1888]

Interval—7 years

Motive of Reissue—To enlarge claims to dominate interim marketed device.

Subject Matter—The patents dealt with soda water fountains and the original claimed a vessel of tin enclosed by a cylinder of steel with a solder of pure tin. The reissue omitted the limitation that the cylinder should be steel and omitted the soldering connection.

HELD

"But the only claim of the original patent is for 'the tin vessel, incased by a steel cylinder, and ends soldered to the latter, in the manner substantially as described;' and the manner described in the specification of fastening the end caps to the body of the outer shell is, 'without flanges or projections, by tin joints, made by soldering with pure tin, which, being a ringing metal, unites closely with the steel exterior to make a firm and durable joint, as other solders having lead in them will not do.'

The patentee himself testified that when he made his invention he knew of others having used iron fountains lined with sheet block tin; that the first fountains he made were soldered with tin and lead solder, usually known as soft solder, and he found that would not do, and therefore adopted a solder of pure tin; and that he dispensed with rivets, because they prevented the fountain being repaired without tearing the shell in taking out the rivets.

In short, by the term of the specification and claim, in the then existing state of the art, and according to the intention of the patentee, his patent was limited to a fountain in which the caps were connected with the outer cylinder by pure tin solder, without rivets or flanges.

In the fountain made by the defendant, on the other hand, the caps are fastened to the body at both ends by a solder of half tin and half lead, as well as by rivets, and there are vertical flanges at one end, through which the rivets pass. It is quite clear, therefore, that if the original patent had remained unaltered, there would have been no infringement.

The reissue was taken out seven years after the original patent, and a year or two after the patentee knew that the defendant was making such a fountain as is now alleged to be an infringement.

The repetition of the original specification in the reissue, word for word, (except only in the unimportant variation

of omitting the word 'closely' in speaking of the fitting of the shell to the lining), as well as the testimony of the patentee, proves that there was no defect or insufficiency in the original specification, and no error, inadvertence or mistake in framing it.

If the omission, in the claim of the reissue, after the mention of the outer cylinder and the ends, of the words 'soldered to the latter,' before the words 'in the manner substantially as described,' still leaves the claim to be construed and limited by the previous description in the specification, the patentee is no better off than if he had not taken out a reissue.

But if the effect of omitting the words in question is to extend the claim to a fountain, the outer cylinder and ends of which are fastened together in any other manner than by a solder of pure tin, the claim is enlarged by omitting an essential element of the patentee's invention, and the reissue is invalid, by the settled law of this court." (350-351)

YALE LOCK MFG. CO. v. JAMES, 125 U. S. 447 [1888]

Interval—8 years

Motive of Reissue—Enlargement of claim and disclosure to cover subject matter abandoned under pressure from Patent Office.

Subject Matter—The original disclosed and claimed individual metal fronts for post office boxes with flanges to overlap and with fastening rivets connecting the individual fronts to each other and to the rear wooden pigeon holes whereby continuous tamper-proof front was presented. The reissue claim was broadened to embrace individual boxes with contiguous but not overlapping flanges and with fastening means holding the individual fronts to the rear wooden pigeon holes but not to each other.

HELD

"In view of these facts, Judge Shipman, in his decision in the present case, said: 'It is unquestionable that the patentee, when he made his original application, intended to say that his invention did not consist simply in making, by his combination of metallic doors, door frames, and wooden boxes, a continuous metallic frontage, but that it also consisted in the way in which the frontage was made continuous, viz. by the connection of the adjoining frames with each other. His definite and exact specification shows that he supposed that his patentable invention was thus limited. He described with precision and clearness, that his metallic frontage was to be so constructed that the frames were to be fastened to each other at top, bottom, and sides, and not merely to the woodwork. 'A specific invention, complete in itself,' was described, 'fully and clearly, without ambiguity or obscurity.' Under the definitions which are given in the decisions which have been referred to, and in *Manufacturing Co.* v. *Ladd,* 102 U. S. 408, of the inadvertence, accident, or mistake which permits a reissue, when a patent is said to be inoperative on account of a defect or insufficiency in the specification, which arose through such inadvertence or mistake, and also of the nature of the defectiveness or insufficiency which is meant by the statute, there was no mistake, although the patentee might have fallen into an error of judgment, or to an erroneous conclusion of fact; and, furthermore, the original patent, according to the definitions contained in the recent, and, perhaps, in the earlier cases, was not defective nor insufficient, either in its descriptive portion or in its claims." (462-463)

"In view of the fact that the Patent Office excluded from the descriptive part of the specification suggestions of any other method of fastening than that by which the frames were to be fastened to each other, it would be singular if

the intent of the Office was to include in the second claim such other method of construction. If this claim has properly, and the applicant knew that it was intended to have, a narrow construction—and of this knowledge I think there can be little doubt—the plaintiff would not insist that the 1st and 2d claims of the present reissue ought, in view of the decision in *Miller* v. *Brass Co., supra* to be so construed as to be any broader than the 3d claim, which requires the combination of door frames, doors, and pigeon holes to be by means of rivets or bolts which attach the frames both to the wood-work and to each other." (463-464)

HOSKIN v. FISHER, 125 U. S. 217 [1888]

Interval—8 years

Motive of Reissue—To add broader claim to dominate interim marketed apparatus.

Subject Matter—The patents concerned hydraulic mining apparatus and the original claimed a combination of ten particular elements. The reissue claimed a single element for connecting two others.

HELD

"In the case of *Wollensak* v. *Reiher*, 115 U. S. 96, the following propositions were laid down by this court: (1) The question whether delay in applying for a reissue of a patent has been reasonable or unreasonable is a question of law for the determination of the court. (2) The action of the Patent Office in granting a reissue, and deciding that, from special circumstances shown, it appeared that the applicant had not been guilty of laches in applying for it, is not sufficient to explain a delay in the application which otherwise appears unreasonable and to constitute laches. (3) Where a reissue expands the claims of the

original patent, and it appears that there was a delay of two years, or more, in applying for it, the delay invalidates the reissue, unless accounted for and shown to be reasonable. These principles are applicable to the present case, and require that the decree of the Circuit Court should be reversed. The delay is not accounted for by the plaintiffs, nor shown to be reasonable." (222)

CORNELL v. WEIDNER, 127 U. S. 261 [1888]

Interval—8 years

Motive of Reissue—To broaden after too long delay.

Subject Matter—The patents dealt with a metal bushing for cask bungs. The original claimed the combination of a notched bushing with a wrench having a projection to fit the notch. It was first reissued in two divisions, one for the wrench and the other for the bushing. The bushing reissue was again reissued to enlarge the claim by omitting the notch.

HELD

"It thus appears that the original patent described a bushing with a V-shaped notch in the flange, and a wrench made with an angular projection to fit that notch, and applied by turning the wrench until the projection fell into the notch; and that all that the patentee claimed as his invention was the combination of the notched bushing with the wrench having a projection to fit it.

On August 6, 1872, the patent was reissued in two divisions No. 5026 (not in this record) being for the wrench, and No. 5027 being for the bushing, describing it as 'an angular ring of metal. * * * ' " (262-263)

"The specification and the claim of that reissue, as clearly appears upon its face, both treated the notch in

the flange of the bushing as an essential element of the invention." (263)

"On June 17, 1879, a second reissue, No. 8759, was obtained for the bushing, * * * " (264)

"The notch in the flange of the bushing is not mentioned either in the specification or in the claim of this reissue, although it is shown in the accompanying drawings, substantially as it was shown in the drawings of the original patent and of the former reissue.

The original patent and the first reissue having been distinctly limited to a bushing having a notch to aid in forcing it into place, the second reissue, obtained nearly seven years later, for a bushing without any such notch, is an unwarrantable enlargement of the supposed invention, which, according to the now well settled law, renders the reissue void." (264-265)

FLOWER v. DETROIT, 127 U. S. 563 [1888]

Interval—8 years

Motive of Reissue—To dominate interim marketed devices.

Subject Matter—The patents dealt with fire hydrants. The original narrowly claimed a combination of particular elements. The reissue broadly claimed a lesser combination.

HELD

"The material difference between the descriptive parts of the two specifications is that, in the reissue, it is stated that the casing C is movable, and that sufficient space is left between the bead *a* upon the hydrant proper, and the upper terminus of the casing C, to permit of sufficient up-and-down play of the casing C to allow it to slide

loosely up and down, to accommodate the upward and downward movement of the earth during the process of freezing and thawing, without any liability to derange the plug or hydrant. The casing could not thus slide loosely up and down, unless sufficient space were left between the bead *a* and the upper terminus of the casing. No suggestion of such arrangement is found in the specification of the original patent, and the drawing of that patent shows no space between the upper terminus of the casing and the bead or flange above it. This is a new matter introduced into the specification of the reissue, contrary to the express inhibition of §4916 of the Revised Statutes.

Claim 1 of the reissue is for an invention not indicated or suggested in the original patent, namely, the independent up-and-down motion of the casing. In addition to this, the drawing of the original patent shows a close contact between the top of the casing and the bead or flange above it, so as absolutely to forbid any such independent up-and-down motion of the casing as is covered by the first claim of the reissue, while the drawing, Figure 1, of the reissue, shows a sufficient space between the top of the casing and the bead or flange above it to admit of such independent up-and-down motion." (569-571)

"In the present case, it cannot be seen from a comparison of the two patents that the original specification indicated that what is covered by the first claim of the reissue was intended to have been secured by the original.

In the present case, also, the reissue was not applied for until nearly eight years after the original patent was granted, and the reissue was taken with the manifest intention of covering, by an enlarged claim, structures which in the meantime had gone into extensive public use, and which were not covered by any claim of the original patent." (571-572)

FARMERS' FRIEND MFG. CO. v. CHALLENGE CORN-PLANTER CO., 128 U. S. 506 [1888]

Interval—1 year, 11 months

Motive of Reissue—To change materially the claimed subject matter, to cover earlier art.

Subject Matter—The patents dealt with corn-planters.

HELD

"It thus appears that while the claims, both of the original patent and of the reissue, relate to a corn-planter having the rear main frame mounted on supporting wheels, and the front runner-frame hinged or pivoted to the main frame, the difference between them is this:

The claim in the original patent is limited to a lever having its front end slotted, and connected with the runner-frame by a bolt passing through the slot, in combination with a shaft journaled at one end to the main frame and at the other to the seat-standard, and with a lifting hand-lever rigidly attached to that shaft, for elevating, depressing and controlling the runner-frame.

In the reissue, on the contrary, the first and fourth claims undertake to cover any form of foot-lever or treadle and hand-lever used in combination for the purpose of elevating or depressing the runners; the second claim differs only in being restricted to a hand lock-lever used in connection with the foot-lever; and the third claim, in requiring the two levers to be rigidly connected.

In the Kelly machine, patented September 14, 1875, and in public use before the plaintiff's invention, a foot-lever and hand-lever had been used in combination, rigidly connected together, (certainly quite as much so as in the defendant's machine), and with a lock on the hand-lever.

The only feature of the plaintiff's machine which can possibly be considered as new is a slotted lever connected

with the runner-frame by a bolt, and the hand-lever mounted upon a shaft journaled at one end to the main frame and at the other end to the seat-standard, thereby facilitating the depressing of the runners by a single movement. The claim in the original patent is limited to a mechanism containing that feature which is not found in the defendant's machine. The enlargement of the claims in the reissue, so as to embrace machines not containing that feature, is void, under the rule established by recent decisions of this court, too numerous and familiar to require citation." (509-510)

PATTEE PLOW CO. v. KINGMAN, 129 U. S. 294 [1889]

Interval—2½ years

Motive of Reissue—To alter description of machine and correspondingly to alter claims in significant and material respects.

Subject Matter—The original disclosed and narrowly claimed a sub-combination of mechanical elements in cultivators. The reissue disclosed and claimed a different sub-combination of elements differently operating.

HELD

"The axle, having plates as described hinged to wheel-spindle plates, is not identical with an axle omitting the first-named plates, or having them so affixed as to become a constituent part thereof. The omission of the plates B and the addition of the direct draft are significant and material changes, and it is well settled that a reissue can only be granted for the same invention intended to be embraced by the original patent, and the specification cannot be substantially changed, either by the addition of

new matter or the omission of important particulars, so as to enlarge the invention as intended to be originally claimed.

Passing to the question of infringement, it will be found that when the extent of the invention is determined, as it must be, by reference to the state of the art, the appellee's machine does not infringe in respect to those parts of the claim which can be held to have been unanticipated." (299)

DOBSON v. LEES, 137 U. S. 258 [1890]

Interval—1 month

Motive of Reissue—To claim in the reissue, subject matter which had been deliberately waived during the prosecution of the application for the original patent.

Subject Matter—The original patent was applied for September 30, 1872 and was granted February 20, 1877. The reissue was applied for March 24, 1877 and granted March 7, 1882. The original patent was for a shaft and bearing of cast iron or of metal of the same crystalline structure as cast iron. The reissue was for a machine comprising a combination of elements.

HELD

"It appears from the record that James Greaves applied September 30, 1872, for a patent for an 'improvement in condensing cylinders for carding engines,' the proposed claim being: 'The application, as described, of cast iron spindles to the condensing cylinders of carding engines.'" (259)

"The application was rejected October 29, 1872, and again rejected December 7, 1872. On the 7th of December, 1874, the following was substituted for the claim: 'A spin-

dle for carding machine rollers, rectangular in form, for the purpose set forth.' This amendment was followed by a redrawn specification, the claim of which was as follows: 'The combination, substantially as described, of the condensing cylinder of a carding engine, the driving wheel A, the hub of which has a square or angular aperture, and the spindle X, having a corresponding shape imparted to that portion of it which slides through the said hub, all as set forth.' This specification was accompanied by a new sheet of drawings marked 'sheet 2,' the drawings originally filed being marked 'sheet 1,' and by a new model. A new oath of invention was required and made, dated January 22, 1875. On the 27th of January the claim of the amended specification was rejected upon reference to Davison and Crowther's English patent No. 2885 of 1856, and others; again rejected on the 26th of February in view of that reference, and also of the patents of Harraday, of May 30, 1854, No. 10,986, and of Warth, of August 6, 1872, Nos. 130,343 and 130,344; again, on March 31, 1875; again, on appeal to the board of examiners in chief, August 7, 1875; and again, by the Commissioner on appeal to him, November 11, 1875. There having been a change of attorneys, on the 12th of October, 1876, an amended specification was filed, and rejection again followed, November 27, 1876. The specification was again amended November 29, so as to set up these two claims:

> '1st. The combination, in a carding engine, of a condensing or rubber cylinder, a driving wheel, and a polygonally-shaped horizontal shaft or spindle, the latter being adapted to be revolved and at the same time to be continuously reciprocated in a correspondingly polygonally-shaped bearing, and a continuously reciprocating rubber, substantially as and for the purposes described.

'2d. In a carding engine, the combination of a continuously reciprocating rubber, a driving wheel to turn said rubber, and a horizontal shaft or spindle connecting the two together said shaft or spindle and the bearing in which it reciprocates being both made of cast iron, or both of metal having the same crystalline structure, whereby in the reciprocating action the tendency of the crystalline particles of cast metal in the bearing to wear the spindle will be resisted by the crystalline particles of the latter, substantially as and for the purposes described.'

This application was rejected December 1. The applicant appealed, and on December 2 the examiner reported that he had rejected the first claim, which did not then require that the spindle and bearing should be of cast iron, upon the ground that its non-patentability was *res adjudicata* so far as the examiner was concerned; and that the second claim was rejected because the substitution of the cast metal shaft for the wrought metal or steel shaft, before employed, required no invention. The examiners in chief, on the 15th of December, reversed the examiner's decision as to the second claim, but affirmed it as to the first, holding, however, that if the first claim were amended so as to include 'cast iron or metal of the same crystalline structure' for bearing and spindle, they thought it would be admissible. The first claim was accordingly amended by the insertion, after the word 'bearing', of the words 'said bearing and said shaft or spindle being of cast iron or of metal of the same crystalline structure.'

On the 11th of January, 1877, an interference was declared between these claims and the application of one Stone, and on the 8th of February, 1877, the examiner refused a motion to dissolve the interference, upon the ground that the feature which Greaves relied on as not shown in the Stone invention was that Greaves' shaft and bearing were made of cast iron of metal having the same

crystalline structure, while Stone's were of cast brass, which would come within the scope of Greaves' claims. It was held by the Assistant Commissioner, on appeal, on the 9th of February, that 'as cast brass has not the same crystalline structure as cast iron, the application of Greaves, if so amended in its claims as to restrict him to the use of metal having the same crystalline structure 'as cast iron,' will not interfere with an application showing and describing 'cast brass,' if the material is of the essence of the invention.' Applicant accordingly so amended February 9, the interference was dissolved February 10, and the patent was issued February 20, 1877.

The result of all this was, that after repeated attempts and repeated rejections, the patent was allowed, containing two claims, limited strictly to a shaft and bearing of cast iron or of metal of the same crystalline structure as cast iron." (259-261)

"Applications were then filed for a reissue in two divisions, A and B—for division A on March 24, 1877, and for division B on March 15, 1877." (262)

"The claim in Division A was as follows:

> 'In a carding engine, a condensing or rubber cylinder mounted on a polygonally-shaped horizontal shaft, in combination with a driving gear, A, having a sleeve-shaped bearing, *b*, said shaft and cylinder being adapted to be revolved by the drivewheel A, and at the same time to be rapidly and continuously reciprocated by suitable mechanism, substantially as and for the purposes described.'

And for this, reissued letters patent No. 10,054 were granted March 7, 1882, and this is the patent in controversy. Before it was passed for issue, various proceedings were had in the Patent Office, including rejections,

appeals, and disposal of an interference between this application and that of Stone, and it appears by the statement of Examiner Appleton, under date of December 5, 1881, that after the determination of the interference the application was returned to the examiner, 'with instructions to consider whether or not, in view of certain recent decisions of the Supreme Court of the United States, the same in its present form can properly be allowed.' The examiner was clearly of opinion that under the decisions of this court in *Powder Company* v. *Powder Works*, 98 U. S. 126; *Leggett* v. *Avery*, 101 U. S. 256; *Manufacturing Co.* v. *Ladd*, 102 U. S. 408; and *Goodyear Dental Vulcanit Rubber Co.* v. *Davis*, 102 U. S. 222, the applicant was not entitled to the claim presented, 'said applicant having withdrawn a similar claim in his original application in order to obtain his original invention and the present claim being for a different invention from that covered by the original patent.' And in his statement of grounds of decision, under date of January 27, 1882, the examiner gave as his reasons: 'In the first place, this claim, being for a combination of parts of peculiar construction, while the original is for a combination of parts when some of the same are constructed of particular metals, the metals being the gist of the claim thereof, is for a different invention from that covered by the original patent. In the second place, the claim now in controversy having been withdrawn from the application upon which the original patent was granted, with a full knowledge of all the facts in the case, it cannot be urged that such withdrawal of the claim, or any other change that the appellant now desires to make was the result of or necessitated by any inadvertence, accident, or mistake, for which alone corrections by reissue can be made.'' (262-263)

''A reissue is an amendment, and cannot be allowed unless the imperfections in the original patent arose with-

out fraud, and from inadvertence, accident or mistake. Rev. Stat. §4916. Hence the reissue cannot be permitted to enlarge the claims of the original patent by including matter once intentionally omitted. Acquiescence in the rejection of a claim; its withdrawal by amendment, either to save the application or to escape an interference; the acceptance of a patent containing limitations imposed by the Patent Office, which narrow the scope of the invention as at first described and claimed; are instances of such omission." (265)

"It is clear that the claim of this reissue is not covered by the original patent, and it appears that before the issue of the latter it was passed upon and rejected; was withdrawn and erased; an interference was dissolved upon condition of the amendment; and the issue of the original letters was predicated upon its abandonment. There is no room for the contention that there was any inadvertence, accident or mistake in the premises. Nor, in the light of these protracted proceedings in the Patent Office, can the applicant be permitted to treat the deliberate acts of his attorney as the result of inadvertence, accident or mistake. The repeated official decisions and orders, and the repeated efforts to maintain this claim without success, during this long struggle, indicate anything but negligence or inadvertence on the part of the solicitors employed." (265-266)

ELECTRIC GAS-LIGHTING COMPANY v. BOSTON ELECTRICAL COMPANY, 139 U. S. 481 [1891]

Interval—10 years

Motive of Reissue—To dominate interim apparatus.

Subject Matter—The patents dealt with electrical apparatus for lighting gas lamps. The original dis-

closure was impractical. The reissue added broader claims to dominate the subject matter of later successful inventions.

HELD

"The only difference of consequence between the original patent No. 130,770, and the reissue No. 9743, is in the claims, the text of the two specifications being almost substantially the same, and the drawings differing only as to scale." (482)

"The trivial verbal changes in the specification of the reissue show that there were no defects or insufficiencies in the specification of the original patent, which required correction; and that the sole object of the reissue was to multiply and alter the claims, which were increased in number from three to six." (487)

"Before the date of patent No. 130,770, numerous patents had been granted by the United States for electric gas-lighting apparatus; and the state of the art was such that no room was left for a pioneer or foundation patent for automatic electric gas-lighting apparatus." (492)

"It appears from those two patents that Tirrell then recognized the state of the art to be such that invention in automatic electric gas-lighting apparatus was limited to the specific mechanism described and claimed, or to its known equivalent." (493-494)

"• • • after the apparatus of No. 230,590 had been put into successful use by the defendant and by other persons who had acquired the right to use the invention from Pinkham, Tirrell was induced by the Franklin Electric Gas-Lighting Company to apply, in February, 1881, for the reissue of No. 130,770." (495)

"Apparatus like that shown in the drawings of No. 130,770 had not operated successfully, and had not been manufactured for several years prior to 1881." (495-496)

"The only motive which the officers of that company had in inducing Tirrell to apply for a reissue of No. 130,770, was to expand its claims so as to cover the invention for which No. 230,590 had been granted." (496)

"In the present case, the original patent was not inoperative or invalid by reason of a defective or insufficient description of the invention, for the text of the specification of the reissue, aside from the claims, is substantially the same as that of the original." (500-501)

"Moreover, the unexplained delay in applying for the reissue must be regarded as fatal to its claims." (501)

"If the claims of the reissue are limited, as they must be, to the specific mechanism described in the specification, it is very clear that the defendant's apparatus does not infringe. It is incapable of being used to light a series of burners. It opens the gas-valve by a single impulse, and closes it by a single impulse. No spark is produced until the gas-valve is fully opened. It has no switching mechanism, or any equivalent therefor, no ratchet-wheel and pawl, and no lever carrying the circuit-breaker. It has two magnets, two armatures, and two electric circuits, the magnets having no connection with each other, one of them being used solely for turning on and lighting the gas, and the other for turning it off, and no spark being produced in the latter operation. Nor has it any lever distinct from the armature; nor is the armature which operates to close the gas-valve ever in combination with the circuit-breaker." (503)

TOPLIFF v. TOPLIFF, 145 U. S. 156 [1892]

Interval—5 months

Motive of Reissue—To broaden claim without excessive delay.

Subject Matter—The patents dealt with carriage springs. The original narrowly claimed a combination of specific elements. It was reissued within four months and a second reissue applied for a month later claiming a combination of certain of the formerly claimed elements and a particular newly claimed element. The respective claims were:

Original	First Reissue	Second Reissue
"The arms CCC'C' arranged upon separate *rock*-rods BB' secured directly to the *front and rear axles* to cause both ends of *each spring* to yield simultaneously and in unison with each other, *and also to be laterally braced by said rock-rods*, as described."	"The arms CCC'C' arranged upon separate *connecting*-rods, BB' secured directly to the *hind axle* and *front bolster*, to cause both ends of *the side-springs* to yield simultaneously and in unison with each other, *in the manner shown* and described."	"2. The combination of the connecting-rod BB' provided with arms at their ends, with the half-elliptic springs AA', substantially as and for the purpose set forth."

The decision in this case reviews at length prior reissue cases and well summarizes the law.

HELD

"The second claim is to some extent a change of the claim of the first reissue. It omits the requirement that the connecting-rod shall be secured directly to the axle and bolster, so as to cause both ends of the side-springs to yield simultaneously, and introduces the half-elliptical springs AA' as a new element of the combination. Whether this be an enlargement of the original claim or not, it is for substantially the same invention, and in view of the fact that the reissue was applied for as soon as the mistake was discovered, and before any rights in favor of third

parties could be reasonably expected to have attached, or had in fact attached, we think this reissue is not open to the objections which have proved fatal to so many since the case of *Miller* v. *Brass Company*, 104 U. S. 350, was decided." (165)

"In the large number of cases which have come up to this court since that of *Mahn* v. *Harwood* was decided, in which reissues have been held to be invalid, it will be found that the opinion of the court was put upon the ground, either that the patentee had been guilty of inexcusable laches, usually of from four to sixteen years, or that circumstances had occurred since the granting of the original patent which made the reissue operate harshly or unjustly to the defendant in the case." (169)

"From this summary of the authorities it may be regarded as the settled rule of this court that the power to reissue may be exercised when the patent is inoperative by reason of the fact that the specification as originally drawn was defective or insufficient, or the claims were narrower than the actual invention of the patentee, provided the error has arisen from inadvertence or mistake, and the patentee is guilty of no fraud or deception; but that such reissues are subject to the following qualifications:

First. That it shall be for the same invention as the original patent, as such invention appears from the specification and claims of such original.

Second. That due diligence must be exercised in discovering the mistake in the original patent, and that, if it be sought for the purpose of enlarging the claim, the lapse of two years will ordinarily, though not always, be treated as evidence of an abandonment of the new matter to the public to the same extent that a failure by the inventor

to apply for a patent within two years from the public use or sale of his invention is regarded by the statute as conclusive evidence of an abandonment of the patent to the public.

Third. That this court will not review the decision of the Commissioner upon the question of inadvertence, accident or mistake, unless the matter is manifest from the record; but that the question whether the application was made within a reasonable time is, in most, if not in all such cases, a question of law for the court.

To hold that a patent can never be reissued for an enlarged claim would be not only to override the obvious intent of the statute, but would operate in many cases with great hardship upon the patentee. The specification and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy, and in view of the fact that valuable inventions are often placed in the hands of inexperienced persons to prepare such specifications and claims, it is no matter of surprise that the latter frequently fail to describe with requisite certainty the exact invention of the patentee, and err either in claiming that which the patentee had not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention. Under such circumstances, it would be manifestly unjust to deny him the benefit of a reissue to secure to him his actual invention, provided it is evident that there has been a mistake and he has been guilty of no want of reasonable diligence in discovering it, and no third persons have in the meantime acquired the right to manufacture or sell what he had failed to claim. The object of the patent law is to secure to inventors a monopoly of what they have actually invented or discovered, and it ought not to be defeated by a too strict and technical adherence to the letter of the statute, or by the application of artificial rules of interpretation. The evidence

in this case shows that plaintiffs were conceded by manufacturers a monopoly of this invention; that defendant was the only one who had infringed their patents; and that he did not begin to manufacture the infringing device until 1882, six years after the second reissue was granted. In view of this and the fact that the second reissue was applied for within five months from the time the original patent was granted, and within thirty-seven days after the first reissue, and that it covers no more than the actual invention of the patentee, so far as the same is an improvement upon the Augur patent, we think it should be upheld." (170-172)

FREEMAN v. ASMUS, 145 U. S. 226 [1892]

Interval—1 year

Motive of Reissue—To claim an entirely different part of apparatus than the parts originally claimed.

Subject Matter—The patents dealt with blast furnaces. The original claimed a particular discharge block and the reissue claimed a particular furnace wall opening.

HELD

"It is apparent, from the description contained in the specification of the original patent, that Lürmann considered his invention to consist essentially of a removable slag-discharge piece, cast with numerous channels or pipes running through it, formed with a dovetail at its upper end fitted into the bottom of a stationary metallic plate connected with the furnace, and provided with channels or pipes so that water might flow through the slag-discharge piece and plate, conjointly or separately, that they might be cooled while the furnace was in operation." (236)

"The fundamental devices claimed by Lürmann as his improvements were (1) the metal plate C, provided with water channels; (2) the removable slag-discharge piece provided with water channels; and (3) the method of regulating the discharge of the slag by raising and lowering the temperature of the slag-discharge piece." (236-237)

"This testimony shows that, instead of desiring merely to remedy formal defects which appeared on the face of the papers, Asmus waited until experience and reasoning had shown him the broadest formula in which to express the claims of his patent so as to cover all possible modifications." (237)

"But the material point is the extension of the invention claimed, by the addition of claim 1 of the reissue, the words in which, 'substantially as set forth,' refer to the new matter in the reissue, that the slag is discharged 'through an opening cooled with water in such a manner that the tymp, or fore hearth, and the wall stone can be dispensed with.' The intention manifestly was to construe the first claim so as to cover any kind of blast furnace with a closed breast, having a slag-discharge opening cooled in any manner or to any extent by water. There is nothing in the original specification which indicates that any such claim was intended to be made in the original patent. On the contrary, the whole purport of that specification shows that it was intended to claim only a slag-discharge piece or cinder block constructed and attached in a specific manner, as is set forth in the statement of the attorneys of Asmus, accompanying his application for the reissue." (239)

"We are of opinion that the present reissue is invalid, so far as the first claim of it is concerned, because it is not

for the same invention as the original patent, and is, therefore, within the express exception of the statute, (Act of July 4, 1836, c. 357, §13, 5 Stat. 122). There is nothing inconsistent with the foregoing views, in our decision in *Topliff* v. *Topliff, ante,* 156." (241)

HUBER v. NELSON MANUFACTURING Co., 148 U. S. 270 [1893]

Interval—1 year

Motive of Reissue—To dominate interim marketed apparatus.

Subject Matter—The patents dealt with flushing chambers. The original narrowly claimed combinations of six elements. The reissue claimed a sub-combination omitting an element which the original had made essential to operativeness and novelty.

HELD

"Being an old device, he could not claim the injector, independently, or otherwise than in combination with other devices forming a part of his improved sanitary water-closet." (282)

"The view taken by Judge Thayer was that the sole purpose of Boyle, in asking for a reissue, was to eliminate the 'flushing-chamber,' as a constituent element of the combination covered by certain claims of the original patent to Boyle, particularly of claim 1, and to obtain a patent for a flushing apparatus like that described in said claim 1, less the flushing-chamber, and so claim 2 of the reissue was granted in the terms above set forth, omitting the flushing-chamber from the combination. It was omitted also from claim 1 of the reissue. The effect of this was to expand the claims of the original patent, because they had

been limited by including the 'flushing-chamber' as an element of the combination." (284)

"* * * that it was manifest from other statements made by Fraser in the course of his testimony, that in his opinion a flushing apparatus minus the flushing-chamber with its attendant devices for securing an after-wash would be practically useless; that some provisions for refilling the bowl after the injector had ceased to act was essential to the successful operation of the flushing apparatus or water-closet, considered as a whole; and that, in drafting the several claims of the original patent, he intentionally and, as it would seem, with great care, included the flushing-chamber, for the reason that it was one of the essential parts of the flushing apparatus, without which the latter would not be serviceable." (287)

"The opinion further states that the testimony showed, to the entire satisfaction of the court, that Fraser was right in supposing that Boyle's flushing apparatus, without the flushing-chamber would be incomplete and therefore practically valueless; * * *" (288)

"The opinion of the Circuit Court further said that the testimony did not tend to establish that either Boyle or Frazer acted so inadvertently or under such misapprehension of either law or fact, when the claims of the original patent were formulated, as to justify a reissue of the patent; that it was obvious to them, as to any one, that the injector would perform its function as well with a single tank as with a tank and flushing-chamber combined; that both of them believed that a water-closet constructed according to Boyle's design, but without provision for an after-wash, would be valueless in the market; that in that belief they were right; that Boyle had discovered no method of producing an after-wash automatically by using

a single water-tank, and hence both he and Fraser regarded the flushing-chamber as one of the essential features of the flushing apparatus intended to be manufactured, and accordingly claimed it industriously in all of the important claims; that even though they claimed the injector in combination with a part which was non-essential to its operation, and thereby limited the claim, yet they did so in pursuance of a well-defined purpose, not based upon a misconception of matters of fact or ignorance of law, so far as the records before the Commissioner of Patents or the proof in this case showed; that the injector was an old device when Boyle adopted it; that it could be claimed only in combination with other parts which would together produce a new result or effect, or constitute a new machine; * * *" (289)

"The opinion further observed that if the injector were new with Boyle, and had not been claimed in the original patent, it might be proper to interpret the law liberally in favor of Boyle, to enable him to realize the full benefit of his invention; that an injector is an old device, and Boyle merely adopted it and applied it to a new use; and that he ought to be limited to that combination in which he deliberately placed and claimed it.

The conclusion of the opinion was that the reissue, being granted merely to enlarge the claims, could not be sustained, citing *Burr* v. *Duryee*, 1 Wa., 531, and *Gill* v. *Wells*, 22 Wall. 1; that the failure to claim the particular combination not claimed in the original patent but claimed in the reissue, was not due to any such inadvertence or mistake as would authorize the claiming of it in the reissue; and that the failure to claim such combination originally occurred under such circumstances, and was accompanied with such full knowledge of all material facts, as to amount to an abandonment of that particular combination to the public.

We are unanimously of opinion that these views of the Circuit Court are sound; and that it is unnecessary to consider the point made by the defendant that the reissue was invalid because it lacked novelty and invention. It is not contended that the defendant has infringed any other claims of the reissue than claims 1 and 2; and we think it entirely clear that the defendant has not infringed any of the claims of the original patent. The defendant had no flushing-chamber in any flushing apparatus made by it; and such flushing-chamber was an essential element in the specification and drawings of the original patent, and was one of the necessary elements in each of the six claims of the original patent, as made. It is impossible to examine the drawings of the original patent and see that the flushing-chamber could be dispensed with in the structure." (290-291)

"In the specification of the original patent, the flushing-chamber had been made an essential element in each of the six claims." (291-292)

"It was not until Boyle obtained knowledge of the Hanson patent that he conceived the idea of claiming such a construction as had been patented to Hanson. Then, and not until then, he announced the idea that it was of value to do away with the flushing-chamber, although the specification of his original patent, in its text and drawings and claims, emphasized the importance of the flushing-chamber as an element in every one of his combinations." (292)

LEGGETT v. STANDARD OIL COMPANY, 149 U. S. 287 [1893]

Interval—4 months

Motive of Reissue—To claim article which the original had disclaimed.

Subject Matter—The original patent was directed to a process of lining a barrel with semi-finished glue. The reissue claimed also the thus treated article.

HELD

"This invention [the original patent] has nothing to do with the glue-lined barrel as an article of manufacture, but relates particularly to a new and inexpensive process of constructing a glue-lined barrel, cask, etc." (289)

"The opinion of the court below is reported in 38 Fed. Rep. 842, and the ground upon which the decision proceeded was that there was a lack of patentable invention in the thing patented.

We are of opinion that there is no error in the judgment of the court below for various reasons. In the first place, the second claim of the reissue, secured, as it was, by important changes in the specification of the original patent, was a manifest enlargement or broadening of the patent. It is not pretended that there was any mistake, accident, or inadvertence in either the specification or the claim of the original patent such as would render it void or inoperative, and warrant the granting of a reissue thereof with an additional and enlarged claim." (292)

"It is shown by the complainant's own testimony that he procured the reissue for the purpose of having it cover barrels so as to make the defendant an infringer." (292)

"This second claim of the reissue, being a manifest attempt to broaden the original patent, cannot, in view of the amended specification on which it was based or procured, be held to cover a glue-lined barrel as an article of manufacture, which was distinctly disclaimed by the original specification." (293)

"In addition to these difficulties in the way of the complainant succeeding in this case, his alleged invention was clearly anticipated by the prior use and sale of liquid glue, or size, used for various purposes, including that of coating barrels." (294-295)

"It being thus clearly established that the use of liquid glue was well known to glue manufacturers and oil refiners, and had been actually applied in the very way and for the very purposes described by the complainant, long before the date of his alleged invention, it is too clear for discussion that he could have no valid patent which would cover a process for using liquid glue for coating or sizing purposes as a new discovery or invention; and our conclusion, therefore, is that the decree of the court below was clearly correct, and should be *Affirmed.*" (297)

CORBIN CABINET LOCK COMPANY v.
EAGLE LOCK COMPANY, 150 U. S. 38 [1893]

Interval—2 years

Matter of Reissue—To cover interim apparatus.

Subject Matter—The original patent claimed a particular construction of cabinet lock. The reissue claimed a different combination of a lock and special mortise.

HELD

"The specification and claim of the original patent, as allowed, described and covered a lock *per se* of a special construction, and did not extend to or include anything in combination therewith.

In the application for reissue, filed April 28, 1883, the original specification was amended in two material respects. The new matter consisted of a statement describ-

ing how a mortise should be formed, and how the lock is to be combined therewith, so as to be held laterally therein, as follows: 'By means of the portions of the walls of the mortise which are in front of the locking-plate G' and in the rear of the front-plate of the lock.' And there was also added this further statement: 'It will thus be seen that the lock is prevented from lateral displacement by the projections upon the back-plate in combination with the corresponding shape of the mortise, and that it is prevented from vertical displacement by the thin strip *m* and bent part G'.' " (41)

"It is perfectly manifest that the new matter in the reissue specification was inserted to lay the foundation for either changing the original claim, or the patent covered thereby; or for the purpose of expanding that claim, so as to make it cover substantially what had been rejected on the original application. An examination of the proceedings in the Patent Office, in connection with the original application, and the claim of the original patent, renders it perfectly obvious that the first claim of the reissue is not for the lock as such, but is for a combination of a lock with a mortise, and in this respect it is for a different invention from that described in the single claim of the original patent, which covered only a lock of definite description. The first claim of the reissue clearly includes, as an element of the combination therein described, a peculiarly constructed mortise to receive the lock. This element the original patent does not indicate as being any part of the invention of the patentee. As already stated, the claim of the original patent is for a lock as such, while the first claim of the reissue is for a combination of that lock with something not claimed as an element in the original patent, viz., a peculiarly shaped mortise. This was a departure from the original claim not warranted by anything appearing in the original specification." (41-42)

DUNHAM v. DENNISON MFG. CO., 154 U. S. 103 [1894]

Interval—1 year

Motive of Reissue—Enlargement to cover interim developments.

Subject Matter—The original disclosure and claim was limited to an end opening envelope to cover the entire side of the envelope. The reissue disclosure and claim was enlarged to cover a combined tag envelope with the flap of the latter of any size and shape.

HELD

"After the defendant had made envelopes with a short flap of semi-circular shape and covering little more than the opening of the envelope, (which, it is admitted, did not infringe the plaintiff's patent as originally issued), the plaintiff obtained a reissue, enlarging the claims, and altering the specification throughout, so as to include an envelope with a flap of any size or shape, and to make the invention consist, not, as in the leading words of the description in the original patent, of 'an envelope with an end flap covering its side,' but in 'a tag provided with means for attaching it to the merchandise, and with an envelope or pocket to receive a bill or invoice of the merchandise.' The words of the description in the original patent were neither technical nor complicated; but they were of the simplest kind, and their meaning and scope could not have been misunderstood by any one who read them with the slightest attention, least of all by the patentee. To uphold such a reissue under such circumstances would be to grant a new and distinct privilege to the patentee at the expense of innocent parties, * * *" (110-111)

OLIN v. TIMKEN, 155 U. S. 141 [1894]

Interval—6 years

Motive of Reissue—To dominate interim marketed construction.

Subject Matter—The patents dealt with vehicle springs. The original narrowly claimed a combination of crossing springs pivoted together at the crossing point. The reissue eliminated the requirement for any connection at the crossing point.

HELD

"As the patent originally stood, the connection of the cross-springs was an essential element of the claim, but, if the reissue were valid, the bolt coupling the two springs together at their centre and forming an articulated joint would in effect be eliminated. The application for reissue was not filed until November 27, 1880, while the original patent was dated December 1, 1874, and the reissue was thus made by expansion to cover structures in public and common use between those two dates.

Huber v. *Nelson Manufacturing Co.*, 148 U. S. 270, is much in point. There one Boyle obtained a patent for a sanitary closet, including, as an essential element of the claim, a flushing chamber, and subsequently applied for a reissue for the purpose of eliminating that chamber. But this; it was held, could not be done.

The object of the original Tilton invention was declared to be to provide carriages or other vehicles with springs to prevent the rocking motion of the body supported thereon, and it was stated in the specification: 'It is well known that elliptic or semi-elliptic springs secured to the centre of the cross-bar of the carriage body will permit the same

to rock from side to side. It is objectionable for various reasons.' It was proposed to remedy this by taking springs of the form shown, which might be properly termed sections of semi-elliptic springs, and arranging them to cross each other on the centre of the cross-bar upon which the body was placed, each spring being provided with a socket at the crossing point and a pivot bolt passing through both springs, secured by a nut, this coupling preventing them from moving independently of each other. In the first claim the words were used, 'hinged together at their crossing point,' in the second claim, 'two leaf-springs, each provided with a socket at their crossing point;' in the third claim, 'the combination of two springs side by side, and connected together, with the side sills and cross-bar, for supporting the body in a horizontal position;' while the fourth claim was for the reenforcing plate and connected cross-springs.

Appellee's contention that the connection of the crossed springs of the third and fourth claims is a connection by means of the reenforcing plate and its flanges, which, the specification says, were intended to serve as bearing points for the ends of the springs, described in the fourth claim as a separate element in combination with the body-supporting bar and the connected cross-springs, requires no comment.

The new fifth claim omits the crossing connection altogether and covers matter recognized as old in the original patent, and claims three and four, if broadly construed in connection with the new matter introduced in the specification, render the central connection non-essential, since it might be omitted, if preferred. There is no basis for the theory of inadvertence, accident, or mistake, and the reissue cannot be sustained." (147-148)

EBY v. KING, 158 U. S. 366 [1895]

Interval—4 years

Motive of Reissue—Alteration of disclosure and enlargement of claim to dominate interim marketed device.

Subject Matter—The original narrowly claimed a subcombination of mechanical elements in a cob carrier for corn shellers. The reissue introduced a new feature and broadly claimed any movable independent cob carrier comprising a specified particular combination of elements.

HELD

"Meantime, however, defendant had, for more than two years preceding the application for the reissue, been manufacturing and selling cob-carriers substantially the same in construction as that shown in the alleged infringing device. It also appears that plaintiff was unable to obtain royalties, or sell licenses under his original patent, by reason of his claims being too narrow; but that since he had succeeded in having the patent reissued with broadened claims, other manufacturers had submitted to his demand for royalties.

Under the rulings of this court, it is clear that this reissue cannot be supported. Not only was there no claim of a defective or insufficient specification; none that the patentee had claimed as his own invention more than he had a right to claim as new; none of inadvertence, accident, or mistake; but four years after the original patent was issued, the patentee attempts to secure a reissue, with claims broadened for the purpose of covering that which is presumed to have been once abandoned to the public. All that has ever been said by this court in restraint of the practice of reissuing patents applies with full force to this case." (372-373)

"But, even if the patentee were able to fall back upon the original patent, counsel for the appellant, as well as his expert, admits that the combination described in the first claim of such patent was anticipated by certain patents to Brinsmead and Bryan, and that described in the second claim was also anticipated by a patent to one Nimbs. Assuming this to be so, it was clearly incompetent for the patentee to abandon these claims *in toto* and recontruct his patent upon a different theory, in order to make it salable, or to hold as infringers other manufacturers who, in the meantime, had entered the field, relying upon his original patent as representing what he claimed to have invented and to be his own." (374)

ABERCROMBIE & FITCH COMPANY, ET AL. v. BALDWIN, ET AL., 245 U. S. 198 [1917]

Interval—7 years

Motive of Reissue—The suit in the Seventh Circuit on the original patent resulted in a holding of non-infringement. The reissue patent was obtained and a suit on it in the Third Circuit resulted in holding that the claim was broader than the original and that the reissue was, therefore, void. A second suit on the reissue in the Second Circuit resulted in a holding that the reissue patent was valid and was infringed by a device like that which the Seventh Circuit held not to infringe the original patent.

Certiorari was granted on conflict of decisions.

Subject Matter—The patents dealt with a lamp to generate and burn acetylene, important elements of which included a tube extending from a water compartment to a calcium carbide compartment and a stirring rod extending through the tube with an end extending into the carbide. As to these the reissue made two changes

from the original; first, that the tube was always embedded in the carbide and second, additional description in the specification as follows:

> "It will be understood from what has been said that the function of the stirrer is to break up, pierce, or disturb the particles of the slaked carbid mass, which, when the lamp is in use, forms at the delivery end of the tube. This slaked carbid mass tends to solidify, and either shuts the water off altogether or restricts it so that less water is delivered from the water tube than the lamp demands for efficient operation. As it is sufficient, under certain circumstances, to insure the requisite flow of water by so manipulating the stirrer as to pierce, break up, or loosen the slaked carbid mass immediately around or at the mouth of the tube, it is obvious that the stirrer need not always be formed with a bent end, or so as to extend radially from the mouth of the tube."

HELD

"The controversy is, therefore, brought to a consideration of the original patent as added to or developed by the reissue. And their comparison centers in a water-feeding duct or tube and its restriction by means of a wire or rod and the shape and use of the rod to pierce or stir the carbide. In the original patent, as we have seen, it was said that the invented method for securing a proper feed (flow of the water to the carbide) without certain specific objectionable features was 'to make the bore of the duct of comparatively large size and then restrict it by means of a wire or rod preferably centrally located therein to leave a channel of the proper size.' In the reissue, after the words 'comparatively large size', it was added—'extend the tube which forms the duct downward so that its end will be always embedded in the carbid.' In other

words, the tube is explicitly described as extending to and its end embedded in the carbide, and this, it is contended, was an enlargement of the original patent.

The contention is untenable if there was in the original patent an implication of such length and termination of the tube, and we think there was." (205-206)

"There is nothing in this but what was clearly implied in the original, except the shape of the stirrer. In the original it is described and represented as bent. In the re-issue it is stated to be obvious that the stirrer need not always be bent 'or extend radially from the mouth of the tube.'

We are unable to assign to this the extent of alteration that counsel do, nor do we think it necessary to rehearse the details of their argument. We have given it attention and the cases it cites, especially the decision and reasoning of the Circuit Court of Appeals for the Third Circuit in *Grier Bros. Co.* v. *Baldwin*, 219 Fed. Rep. 735, but we are constrained to a different conclusion. Indeed, we are of opinion that the original patent did not need the exposition of the re-issue. It exhibited an invention of merit, certainly one entitled to invoke the doctrine of equivalents. *Paper Bag Patent Case*, 210 U. S. 405. Baldwin, the patentee, complied with the statute (§4888, Rev. Stats.) by explaining the principle of his invention and the mode of putting it to practical use; there was a clear exposition of the principle and the instruments of its use were defined and their purpose and manner of operation. It left nothing in either for further experiment or contrivance." (207)

"Whether the rod was bent or made straight was unimportant. In either form it removed the slake and secured the continuous operation of the water and carbide and through them the formation of the gas and its illuminating purpose. One or the other might be better, according

to the extent of the dispersion required, and one naturally suggested the other." (208)

"We do not think the case calls for extended discussion. It is best considered in broad outline. The scope and merit of the patents are of instant and assured impression, and to the attempt to defeat or limit their invention by the state of the prior art we adduce the discussion and reasoning of the opinion of the lower courts, which we approve." (208)

"The denial of infringement is also easily disposed of. Indeed, it has been in effect disposed of. It is based on the contention that the stirrer is an essential of plaintiff's lamp and that a stirrer is absent from defendant's lamp, which is in all other particulars, as far as this case is concerned, similar to the plaintiff's lamp. To the contention of defendants, therefore, we cannot assent. There is a stirrer in both, and its form as we have seen, is not of the essence of the invention." (209)

VANDENBURGH v. TRUSCON CO., 261 U. S. 6 [1923]

Interval—9½ years

Motive of Reissue—To alter subject matter claimed to entrap materially different interim devices.

Subject Matter—The patents dealt with reinforcing bars for strengthening concrete.

HELD

"The preferred form of Vandenburgh for the engagement between his reinforcing bar and the spiral loops of his truss arrangement is by a kerf or cut in the edge of bar inclined away from its center in which the coil rod is

placed and held therein by an integral spur forced downward upon the coil when inserted, which permanently retains it in position. The defendant has a rectangular cut in the edge of the T spacer or upright and retains the spiral rod in it by peening or hammering down the edges of the cut so as to keep the rod from slipping out, but leaving play enough to permit the collapsing of the spiral and shipment in its collapsed form. Others had adopted a similar form of engagement. Observing this, Vandenburgh who had not used or exploited his original patent in any way, went back to the patent office and secured a reissue in which he was permitted to broaden his first and second claims with respect to the kerfs and spurs so as to change the word 'rigidly' used in the original claim to 'permanently.' Having done this, he proceeded to sue in the second, third and sixth circuits persons using what he insisted were equivalents of his form of engagement in their column hooping reinforcement of concrete columns. All the courts, and there are six of them, have held these changed claims of the reissued patent to be void and to give him no right to claim infringement in the collapsible feature of the column hooping. The original specifications leave no doubt that the patentee used the word 'rigidly' deliberately and properly because his truss, as he protrayed it, required rigid connection between the spiral loops and the main reinforcing bar. His making his form of engagement loose was an afterthought to catch makers who had not been advised in his specifications that there was anything collapsible in his truss formation. The reissue as to the first two claims was in the teeth of the admonitions of this Court speaking through Mr. Justice Bradley in *Miller* v. *Brass Co.*, 104 U. S. 350. They are therefore void." (13-14)

"It is clear to us that Vandenburgh having secured a patent for a truss form of reinforcement and finding it

unworkable, for it never has been adopted in the trade or in any structure, is through reissue seeking to expand the paper combination he claims into a field in which it does not belong." (15)

KELLER v. ADAMS-CAMPBELL Co., 264 U. S. 314 [1924]

Interval—6 months

Motive of Reissue—To broaden claims

Subject Matter—The patents were for auxiliary wing type windshields for automobiles in which clamps gripped the ends of the glass. In the defendant's device these clamps were held through perforations in the glass near the center and not at the ends.

The case was decided on non-infringement but the Court recognized the propriety of a broadened reissue.

HELD

"This was a suit to enjoin the infringement of a patent for an improvement in auxiliary windshields for automobiles. It was brought on a reissued patent. The reissue was granted on the ground that the original patent was inoperative to protect the real invention due to defective and insufficient and too narrow claims, all of which arose through inadvertence and mistake due to misunderstanding between the inventor and his solicitor." (315)

"That a reissued patent enlarging claims of the original, although not specifically mentioned in §4916, Rev. Stats., is authorized by that section, when the failure to claim the larger claims justified by the actual invention was due to inadvertence, accident or mistake, is settled by the decision of this Court in *Topliff* v. *Topliff*, 145 U. S. 156, and other cases." (317)

SONTAG CHAIN STORES CO., LTD. v.
NATIONAL NUT COMPANY, 310 U. S. 281 [1940]

Interval—1 year, 7 months

Motive of Reissue—To enlarge claims for dominating interim marketed machine.

Subject Matter—The case reached the Court by certiorari as to a defense of invalidity on account of laches and as to a defense of intervening rights. The decision passed only on the latter question, though the Court recognized the propriety of broadened reissues under proper conditions.

HELD

"Respondent was moved to obtain the reissue by petitioner's use of the accused machine." (282)

"In the case under consideration, the patentee might have included in the application for the original patent, claims broad enough to embrace petitioner's accused machine, but did not. This 'gave the public to understand' that whatever was not claimed 'did not come within his patent and might rightfully be made by anyone.' The enlarged claims were presented with knowledge of the accused machine and definite purpose to include it.

Recapture within two years of what a patentee dedicates to the public through omission is permissible under specified conditions, but not, we think, 'at the expense of innocent parties.'"